(20,247.)

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1906.

No. 288.

EMIL WERCKMEISTER, PLAINTIFF IN ERROR,

vs.

AMERICAN TOBACCO COMPANY.

IN ERROR TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

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a United States Circuit Court of Appeals for the Second Circuit.

EMIL WERCKMEISTER, Suing for Himself and the United States, Plaintiff in Error (Plaintiff Below),

vs.

THE AMERICAN TOBACCO COMPANY, Defendant in Error (Defendant Below).

Transcript of Record.

Error to the Circuit Court of the United States for the Southern District of New York.

[Stamped:] United States circuit court of appeals, second circuit William Parkins, clerk, Filed Sep. 12, 1905.

1 UNITED STATES OF AMERICA, *ss:*

The President of the United States of America to the Judges of the Circuit Court of the United States for the Southern District of New York, Greeting:

Because in the record and proceedings, as also in the rendition of the judgment of a plea which is in the Circuit Court, before you, or some of you, between Emil Werckmeister, suing for himself and the United States, Plaintiff, and American Tobacco Company, Defendant, a manifest error hath happened, to the great damage of the said Emil Werckmeister, suing for himself and the United States, as is said and appears by his complaint. We, being willing that such error, if any hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Judges of the United States Circuit Court of Appeals for the Second Circuit, at the City of New York, together with this writ, so that you have the same at the said place, before the judges aforesaid, on the 23d day of June, 1905, that the record and proceedings aforesaid being inspected, the

2 said Judges of the United States Circuit Court of Appeals for the Second Circuit, may cause further to be done therein, to correct that error, what of right and according to the law and custom of the United States ought to be done.

Witness, the Honorable Melville W. Fuller, Chief Justice of the Supreme Court of the United States, this 25th day of May, in the year of our Lord one thousand nine hundred and five and of the Independence of the United States the one hundred and twenty-nine.

[L. S.] JOHN A. SHIELDS,
Clerk of the Circuit Court of the United States of America, for the Southern District of New York, in the Second Circuit.

The foregoing writ is hereby allowed.

E. H. LACOMBE,
U. S. Circuit Judge.

UNITED STATES OF AMERICA, *Southern District of New York, ss:*

I, John A. Shields, Clerk of the Circuit Court of the United States of America, for the Southern District of New York, in the Second Circuit, by virtue of the foregoing Writ of Error, and in obedience thereto, do hereby certify, that the following pages, numbered from three to 96, inclusive, contain a true and complete transcript of the record and proceedings had in said Court in the cause of Emil Werckmeister, suing for himself and the United States, Plaintiff-in-Error, against American Tobacco Company, Defendant-in-Error, as the same remain of record and on file in said office.

In testimony whereof, I have caused the seal of the said
3 Court to be hereunto affixed, at the City of New York, in the Southern District of New York, in the Second Circuit, this 20th day of July, in the year of our Lord one thousand nine hundred and five and of the Independence of the United States the one hundred and thirtieth.

[L. S.] JOHN A. SHIELDS, *Clerk.*

(Endorsed:)—The U. S. Circuit Court of Appeals for the Second Circuit.—Emil Werckmeister, suing for himself and the United States, Plaintiff-in-Error, *vs.* American Tobacco Co., Defendant-in-Error.—Writ of Error.—Briesen & Knauth, Attorneys for Plaintiff-in-Error, 49 Wall St., N. Y.—Due service of a copy of the within Writ of Error is hereby admitted this 27th day of May, 1905.—Wetmore & Jenner, Attorneys for Defendant-in-Error.—U. S. Circuit Court, Southern District New York.—Filed May 27, 1905.—John A. Shields, Clerk.

4 United States Circuit Court, Southern District of New York.

Action No. 2.

EMIL WERCKMEISTER, Suing for Himself and the United States,
against
AMERICAN TOBACCO COMPANY.

To the above-named Defendant:

You are hereby summoned to answer the complaint in this action and to serve a copy of your answer on the plaintiff's attorneys within twenty days after the service of this summons, exclusive of the day of service; and in case of your failure to appear, or answer, judgment will be taken against you by default for the relief demanded in the complaint.

Witness, the Honorable Melville W. Fuller, Chief Justice of the United States, at the Borough of Manhattan in the City of New

York, this 17th day of July, in the year one thousand nine hundred and three.

[L. S.] JOHN A. SHIELDS, *Clerk.*

BRIESEN & KNAUTH,
Plaintiff's Attorneys.

Office and Post Office Address, 49 Wall St., Borough of Manhattan, New York City.

5 Circuit Court of the United States for the Southern District of New York.

No. 2.

EMIL WERCKMEISTER, Suing for Himself and the United States, Plaintiff,
against
AMERICAN TOBACCO COMPANY, Defendant.

The amended complaint of the above-named plaintiff against the above-named defendant, respectfully shows to this Court, upon information and belief:

First. That said plaintiff, during the times hereinafter stated was and is a citizen of the German Empire, doing business at the City of Berlin, in Germany, under the trade name of "Photographische Gesellschaft," and at the City of New York, in the United States, under the name of "Berlin Photographic Company."

Second. That said defendant is a corporation, duly incorporated under the laws of the State of New Jersey, and having a place of business in the Borough of Manhattan in the county and State of New York, in the Southern District of New York.

Third. That shortly previous to the second day of April, 1894, one W. Dendy Sadler, a British subject, invented, designed and
6 painted a certain painting called "Chorus," said painting showing a group of gentlemen sitting and standing around a punch bowl, and holding pipes and filled glasses in their hands and singing in chorus; and said painting, by reason of its artistic grouping, its excellent drawing of the figure and faces, and its skillful execution, is a piece of art of very great merit and value.

Fourth. That the said W. Dendy Sadler, on or about the second day of April, 1894, by an instrument in writing, executed and delivered on the said day and previous to any publication of said painting in any manner or form, assigned, transferred and sold to said plaintiff for a valuable consideration, all his right, title and interest in any copyright obtainable thereon in the United States of America and in all other countries, and the sole liberty and right of printing and reprinting, publishing, completing, copying, executing, finishing and vending said painting.

Fifth. That having acquired the right to obtain such copyright for said painting and being a subject of the Emperor of Germany,

and desiring to secure the copyright thereof under the laws of the United States of America respecting copyrights, and the sole right of printing and reprinting, publishing, completing, copying, executing, finishing and vending the same, said plaintiff, before the publication thereof in this or any foreign country, to wit, on the sixteenth day of April, 1894, delivered to the Librarian of Congress at his office at Washington, District of Columbia, a description of said painting, to wit, "Chorus,"—W. Dendy Sadler, "A Company of Gentlemen with filled Glasses, singing in Chorus," and also a photo-
graph thereof, and at the same time said plaintiff paid to
7 the said Librarian of Congress the sum of one dollar ($1.00)
for recording said description, and thereupon said Librarian of Congress duly received the same and recorded said description of said painting on the sixteenth day of April, 1894.

Sixth. That the first condition of Section 4970 of the Statutes of the United States, whereby the plaintiff is entitled to the benefit of copyright on substantially the same basis as citizens of the United States, existed before the sixteenth day of April, 1894, as determined by proclamation of the President of the United States, dated April 15th, 1892.

Seventh. That thereafter, on or about the first day of June, 1894, and not before, said plaintiff began the publication of said painting in this country and in foreign countries, by the sale of copies thereof.

Eighth. That by reason of the premises and the statutes in such cases made and provided, there was secured to said plaintiff, his executors, administrators and assigns, or intended so to be, for the term of twenty-eight (28) years from said sixteenth day of April, 1894, the sole liberty of printing and reprinting, publishing, completing, copying, executing, finishing and vending the said painting "Chorus," and that said plaintiff thereupon became, has at all times hereinafter mentioned been, and now is, the proprietor of said copyright.

Ninth. That said plaintiff has duly given notice of his copyright, as is required by law, by inscribing upon a visible portion of every copy of said painting published by him, or of the substance on
which the same were mounted, the word "Copyright,"
8 together with the year the copyright was entered, and the
name of the party by whom it was taken out, thus: "Copyright, 1894, by Photographische Gesellschaft."

Tenth. That after the recording of the description of said painting "Chorus" and within two years previous to the commencement of this action, contrary to the provisions of Title LX, Chapter III of the Laws of the United States, said defendant, without the consent of the plaintiff, the proprietor of said copyright, first obtained in writing, signed in presence of two or more witnesses, did work, copy, print and publish copies of said copyrighted painting within the jurisdiction of this Court and elsewhere in the United States of America, in violation of said plaintiff's copyright and with full knowledge of the plaintiff's claims thereunder, for its use as advertisements of tobacco.

Eleventh. That on or about the 23d day of June, 1902, and previous to the commencement of this action, said plaintiff commenced an action in this Court against said defendant, in the nature of an action of replevin, for the purpose of recovering whatever plates on which said unlawful copies were copied, and whatever sheets thereof, either copied or printed, might be found in said defendant's possession and forfeited to the said plaintiff in accordance with the copyright statute of the United States; that at the time of the commencement of said action, said plaintiff duly applied for and obtained from this Court a writ of replevin upon filing a bond therefor, as required by the statute, and on said 23d day of June, 1902, the Marshal of this Court, in pursuance of the directions of said writ, proceeded to the place of business of said defendant at
9 No. 111 Fifth avenue, in the City of New York, and there found in said defendant's possession two hundred and three (203) separate sheets, each containing a copy of said painting "Chorus," made in violation of said plaintiff's copyright as aforesaid, within the jurisdiction of this Court, which said Marshal duly seized and took into his possession.

And that thereafter, on or about the 22d day of July, 1902, said plaintiff duly applied for and obtained from this Court another writ of replevin, upon filing a bond therefor as required by the statute, and on or about the 29th day of July, 1902, the Marshal of the Western District, to whom said writ was directed, found and seized in said defendant's possession, at the place of business of the Deuther Manufacturing Company, at Buffalo, in the State of New York, nine hundred and ninety-three (993) sheets each containing a copy of said painting "Chorus," made within the jurisdiction of this Court, in violation of said plaintiff's copyright, as aforesaid, which said Marshal duly seized and took into his possession.

Twelfth. That by virtue of the statutes of the United States and of Title LX, Chapter III thereof, said defendant has forfeited and did become and is indebted to said plaintiff and to the United States of America in a penalty of ten dollars ($10) for every sheet containing a copy of said painting, "Chorus," made in violation of said plaintiff's copyright and found in said defendant's possession, as aforesaid, one-half thereof to go to said plaintiff, and one-half to the United States.

Thirteenth. And that by reason of the premises, and by force of the statute in such cases made and provided, an action has accrued to said plaintiff to demand and have of and from the said
10 defendant the said penalty so forfeited and owing as last above specified.

Wherefore, said plaintiff demands judgment for himself and the United States of America against the said defendant for the sum of ten thousand dollars ($10,000), half thereof to be paid to him and half to the United States, together with the costs of this action.

BRIESEN & KNAUTH,
Plaintiff's Attorneys, 49 Wall Street, New York.

SOUTHERN DISTRICT OF NEW YORK,
State of New York, County of New York, ss:

Antonio Knauth, being duly sworn, deposes and says:

That he is one of the attorneys for the plaintiff in the foregoing amended complaint; that he has read said amended complaint and knows the contents thereof, and that the same is true except only the allegations therein stated to be on information and belief, and that as to those allegations he believes it to be true. Deponent further says that the reason why this verification is not made by said plaintiff is that said plaintiff is not in this country, but is a resident of Berlin in the Empire of Germany, and not at present in this country and capable of making this affidavit; and that the sources of deponent's information, and the grounds of his belief concerning the matters stated to be alleged on information and belief in said amended complaint, are the possession of the certificate of the copyright referred to in said complaint issued by the Librarian of Congress, correspondence and personal interviews with the
11 plaintiff, correspondence with the defendant and its attorney, and the personal examination of the defendant's infringing picture.

ANTONIO KNAUTH.

Sworn to before me this 21st day of December, 1903.

OTTO V. SCHRENK,
[SEAL.] *Notary Public, N. Y. County.*

Circuit Court of the United States for the Southern District of New York.

Action No. 2.

EMIL WERCKMEISTER, Suing for Himself and the United States, Plaintiff,
vs.
AMERICAN TOBACCO COMPANY, Defendant.

The above-named defendant answers the complaint of the plaintiff and for answer says:

I. This defendant has no knowledge or information sufficient to form a belief as to any of the matters set forth in the complaint of the plaintiff, excepting that—

This defendant admits that it is a corporation duly incorporated under the laws of the State of New Jersey and that it has a place of business in the Borough of Manhattan in the County and
12 State of New York and Southern District of New York, and excepting that—

This defendant admits that on or about the 26th day of June the defendant had certain lithographed pictures which had been made for the defendant by the American Lithographic Company, and which this defendant now understands and believes are claimed by

the plaintiff herein to be an infringement of the alleged copyright mentioned in the complaint herein, but how many of such pictures were in the possession of the defendant or its employees this defendant has no knowledge or information sufficient to form a belief, and therefore denies the allegation contained in the complaint in that behalf, excepting that—

This defendant is informed and believes that certain pictures, were on or about the 26th day of June, 1902, and at the instance and by the procurement of the plaintiff, seized by the Marshal of this Court and were carried away by him, and that the number of said pictures so seized and carried away by said Marshal was one hundred and thirteen, and excepting that.

This defendant denies the allegations contained in the tenth, twelfth and thirteenth paragraphs of the complaint.

For a further and separate defense, referring to the denials, admissions and allegations hereinbefore contained material to this separate defense, with the same force and effect as if the same were here at length repeated, this defendant alleges:

II. Upon information and belief, that if any such copyright was obtained by the plaintiff as is set forth in the complaint herein, which however, the defendant does not admit but denies as aforesaid, the same was and is void for the reason that the plaintiff, at the time of taking out the said copyright, was not and never had or has
13 been either the author, inventor, designer or proprietor of the said painting "Chorus," alleged in the complaint herein to have been copyrighted nor the assignee of the author, inventor, designer or proprietor thereof, and had no right or authority under the statute relating to copyright to take out or obtain any copyright thereon.

For a further and separate defense to the cause of action set forth in the complaint, this defendant, referring to the denials, admissions and allegations hereinbefore contained material to this separate defense, with the same force and effect as if the same were here at length repeated, alleges upon information and belief, as follows:

III. That if any such copyright was obtained by the plaintiff, as is set forth in the complaint herein, which, however, this defendant does not admit, but denies, as aforesaid, the same was and is void and was abandoned to the public and the plaintiff had and has no right to maintain any action thereon for the reason that the said painting, "Chorus," alleged in the complaint to have been copyrighted, was publicly exhibited by the author and proprietor thereof at the exhibition of the Royal Academy of Arts held in the City of London, England, from the first Monday of May in the year 1894, to the first Monday in August in the same year, both days inclusive, and continuously during said period, and was, during the whole of the said period, exhibited to the public and published and that there was not, at any time during the said exhibition, nor before, nor at any time since, any notice of the said copyright inscribed upon some visible portion of the said painting of on the substance on which the same was mounted as required by the statute in such case made

and provided, and that such exhibition and publication was
14 with the knowledge, consent and permission of the plaintiff and the said Sadler, the author and proprietor of said painting.

Wherefore, the defendant demands judgment that the complaint be dismissed, with costs, that the plaintiff be required to return the copies of said pictures so seized by the Marshal of this Court, or the value thereof, and that the defendant have judgment against the plaintiff by reason of the damages caused by the taking and detention thereof.

WETMORE & JENNER,
Defendant's Attorneys.

No. 34 Pine Street, Borough of Manhattan, New York City.

UNITED STATES OF AMERICA, *Southern District of New York, ss:*

Percival S. Hill, being duly sworn, deposes and says:

That the foregoing answer is true of my own knowledge excepting the matters therein stated to be alleged upon information and belief, and — to those matters I believe it to be true. That the reason why this verification is not made by the defendant is that the defendant is a corporation, that I am the First Vice-President thereof, that my information has been derived from employees of the defendant and from officers and employees of the American Lithographic Company having knowledge or information on the matters set forth in the answer, and the statements made to me by such persons are the grounds of my belief.

PERCIVAL S. HILL.

Sworn to and subscribed before me this 8th day of September, 1903.

[SEAL.]

M. E. FINCH,
Notary Public (*No.* 24)
in and for the County and State of New York.

15 (Endorsed:) United States Circuit Court, Southern District of New York.—Emil Werckmeister, Plaintiff, *vs.* American Tobacco Company, Defendant.—Answer.—Wetmore & Jenner, Att'ys for Def't, 34 Pine St., New York.—U. S. Circuit Court, Southern District New York.—Filed Sep. 9, 1903.—John A. Shields, Clerk.

At a Stated Term of the Circuit Court of the United States of America, for the Southern District of New York, in the Second Circuit, held at the United States Court Rooms in the Borough of Manhattan, in the City of New York, on Monday, the 12th day of December, in the year of our Lord one thousand nine hundred and four.

Present—The Honorable Hoyt H. Wheeler, Judge.

EMIL WERCKMEISTER, Suing for Himself and the United States,
vs.
AMERICAN TOBACCO COMPANY.

Now comes the plaintiff by Antonio Knauth, Esq., his attorney, and moves the trial of this cause. Likewise comes the defendant by William A. Jenner, Esq., its attorney. Thereupon a jury is impaneled and the cause proceeds to trial.

16 After hearing the evidence for the plaintiff and the arguments of counsel, the jury, by direction of the Court, find a verdict in favor of the defendant.

Mr. Knauth moves for a direction of a verdict in favor of the plaintiff.

Denied.

Mr. Knauth moves to set the verdict aside and for a new trial.

C. A. V.

Stay of sixty days after entry of judgment within which to make and serve a case with leave to turn the same into a Bill of Exceptions granted to plaintiff.

An Extract from the Minutes.

JOHN A. SHIELDS, *Clerk.*

Circuit Court of the United States, Southern District of New York.

EMIL WERCKMEISTER, Suing for Himself and the United States,
Plaintiff,
vs.
AMERICAN TOBACCO COMPANY, Defendant.

Penalty Action.

The issues in this action having been brought on for trial before the Hon. Hoyt H. Wheeler, United States Judge, and a jury at a stated term of this Court, held in the court rooms thereof, in

17 the Post Office Building, in the Borough of Manhattan, City of New York, on the 12th day of December, 1904, and the issues having been tried and a verdict rendered by the direction of the Court in favor of the defendant, and plaintiff having thereafter made a motion for a new trial, and the Court having filed an opinion on the 23d day of March, 1905, denying said motion and directing judgment on the verdict, now, therefore, on motion of Wetmore & Jenner, attorneys for the defendant, it is—

Ordered and adjudged that said motion for a new trial be and the same hereby is denied, and it is

Further ordered and adjudged that the defendant, American Tobacco Company, have judgment against the plaintiff, Emil Werckmeister, upon all the issues in this action, that the complaint be dismissed upon the merits, and that the defendant recover of the said plaintiff the sum of ($24.90) Twenty-four 90/100 dollars, costs and

disbursements of this action, and that the defendant have execution therefor.

Dated New York, March 29th, 1905.

JOHN A. SHIELDS, *Clerk.*

(Endorsed:) U. S. Circuit Court, S. D. of New York.—Emil Werckmeister, suing on behalf of himself and the United States, Plaintiff, *vs.* American Tobacco Company, Defendant.—Judgment.—Wetmore & Jenner, Att'ys for Def't, 34 Pine St., New York.—U. S. Circuit Court, Southern District of New York.—Filed Mar. 29, 1905. John A. Shields, Clerk.

18 Circuit Court of the United States, Southern District of New York.

Demurrer No. 2.

EMIL WERCKMEISTER, Suing for Himself and the United States, Plaintiff,

vs.

AMERICAN TOBACCO COMPANY, Defendant.

Bill of Exceptions.

At a term of the Circuit Court of the United States held in and for the Southern District of New York, at the Court Room in the Post Office Building in the City of New York, Borough of Manhattan, State of New York, before the Hon. Hoyt H. Wheeler, U. S. District Judge, on the 12th day of December, 1904, the issues joined by the parties herein upon the pleadings, came on to be heard before the Court and a jury, for that purpose duly empanelled, at which date came there as well said Emil Werckmeister, plaintiff, by Antonio Knauth, his counsel, and the said American Tobacco Company, by William A. Jenner and Oscar W. Jeffery, its counsel, and the jurors for that purpose duly empanelled to try the said issues being called, also came then, and were then and there in due manner chosen and sworn to try the said issues and then and thereupon the trial proceeded as follows:

The jury was empanelled and sworn.

19 *Opening for Plaintiff.*

By PLAINTIFF'S COUNSEL: This action is brought to collect from the defendant, the American Tobacco Company, a penalty under Section 4965 of the Copyright Statute for having published a certain number of copies of the painting in question. Previous to bringing this action, which is called Action No. 2, against the American Tobacco Company, the plaintiff, Emil Werckmeister, had commenced another action in this Court in the nature of an action of replevin, under which action a writ of replevin was issued and was

made good against the defendant by seizing in the hands of the defendant certain copies of the picture in question. This previous action of replevin, which is pleaded in the complaint, has in the meantime been tried in this Court. It was tried before His Honor Judge Townsend, sitting with a jury, and at the end of the trial the Judge directed the jury to bring in a verdict for the plaintiff in that action for replevin, and since then a judgment has been entered in that action.

I shall claim here that the proceedings in this previous action of replevin, being undertaken in accordance with the provisions of the same Section of the statute, and having resulted in a judgment between the plaintiff and this defendant here, upon the same questions in issue, are *res adjudicata,* and for that reason I shall confine myself to offering in evidence here before your Honor, the pleadings and the proceedings, that is, the judgment in that former action, and ask a judgment from this Court to direct the jury to find a verdict likewise. That will be the end of the proceeding which I intend to have before your Honor.

Plaintiff's counsel offers in evidence the summons in this
20 action which is now being tried, Action No. 2, which is dated on the 17th day of July, 1903.

The COURT: We will take the date of it as showing the commencement of the suit.

Plaintiff's counsel offers the summons only for the purpose of showing that the action was not commenced previous to the 17th day of July, 1903.

The summons is marked "Exhibit A" (see page 10*a*).

By PLAINTIFF'S COUNSEL: I will also offer in evidence the papers in an action between the plaintiff, Emil Werckmeister, and the defendant, the American Tobacco Company, in this Court, commenced on June 20, 1902, the papers being the summons, the amended complaint in that action; also the defendant's answer to the amended complaint in that action; the plaintiff's reply to the answer; also a certified copy of the minutes of this Court of the trial of that action, the notice of taxation of costs dated November 28, 1904, and a bill of costs, together with the taxation thereof, at the sum of Eighty-nine and 30/100 dollars ($89.30) on December 2, 1904, by the Clerk of this Court; also a certified copy of the judgment entered in the replevin action which was approved of as to the form of the judgment by the defendant's attorneys and was entered and filed in the office of the Clerk of this Court on December 5, 1904. All these papers I offer in evidence, being the entire judgment roll.

Mr. JENNER: I object to the admission in evidence of the judgment roll on several grounds, which, as briefly as possible, I will proceed to state to your Honor.

In the first place, I base the objection on the ground that
21 the pending case is a criminal case, and the former action, in which the offered judgment was obtained, was also a criminal case; and there can be no estoppel in a criminal case in favor of the prosecutor. While a defendant may plead an acquittal in bar of a second prosecution, on the ground that he may not be put in

jeopardy twice for the same offence, the prosecutor cannot prove a former conviction. I make that on the authority of the United States *vs.* McKee, 4 Dillon, 128, where Mr. Justice Miller, of the Supreme Court, delivered the opinion, with whom sat, and concurred, Judge Dillon, then Circuit Judge, and who held exactly that proposition.

The COURT: What was the prosecution there?

Mr. JENNER: For a forfeiture.

The COURT: For a penalty?

Mr. JENNER: For a penalty; and that case was approved by the United States Supreme Court in Coffey *v.* U. S., in 116 U. S., 436, at page 445. Your Honor perceives that the objection is based upon the proposition that this action is a criminal action; although in form civil, yet in its nature it is criminal; and the former judgment was also obtained in a like case, civil in form but criminal in its nature; though that would make no difference because a judgment obtained in a strictly civil case, that is a case civil both in its form and its substance, would equally not be applicable as estoppel. That obliges me to show to your Honor that this is in reality a criminal action; and I base that proposition upon the authority of Boyd *vs.* United States, 116 U. S., at the top of page 634, where a question of a forfeiture under the revenue laws arose, brought in an action which was civil in form, but in which the Supreme Court said that substantially

all cases which involve penalties and forfeitures were crimi-

22 nal in their nature and, notwithstanding their form, which as civil, were to be regarded as criminal cases. Also, on the authority of Bolles *vs.* The Outing Company, in 175 U. S., at page 264, which holds respecting this statute, Section 4965, that it is penal, as it provides an arbitrary amount as a penalty irrespective of the profits or damages which may accrue to the copyright owner. The case of Falk *vs.* Curtis Publishing Co., 127 Fed. Rep., at page 972, decided to Judge McPherson, in the Eastern District of Pennsylvania, held that this section 4565, was highly penal. One-half of the penalty which may be recovered, or which at any rate is claimed in this action, if recovered would belong to the United States. In all penalty actions the government is the party entitled to sue for them and it is only by an express provision of the statute that an informer has authority to sue for a penalty; and if the government should maintain an action here for the recovery of the penalty, very clearly this would be a penal action, as that would be a penal statute; and the amount of the penalty would be the fine which the Government would impose for the wrong done against its law. In view of the revenue cases and of many other cases, the Government sees fit to give one-half of the fine to the informer, leaving, nevertheless, the penal nature and the criminal nature of the action, and the penal nature of the statute, to remain as it was. Judge Coxe also, in this Circuit, has held that it is a highly penal action and that in substance it is a criminal action.

The COURT: For what purpose do you introduce this? What do you expect to establish by this?

By PLAINTIFF'S COUNSEL: I claim that the issues in this action,

being identical with the issues in the former action of replevin, and having been tried in a civil action between these two parties,
23 the plaintiff and the defendant, are *res adjudicata* since they have been decided by a Court of competent jurisdiction.

The COURT: Are the issues the same?

By PLAINTIFF'S COUNSEL: Exactly the same. They are precisely the same.

The COURT: In an action of replevin, intending to seize these plates and copies, if it came into Court for trial the question would be whether the plaintiff was entitled to the property, would it not?

By PLAINTIFF'S COUNSEL: Yes, that was the issue in that action.

The COURT: By way of forfeiture?

By PLAINTIFF'S COUNSEL: By way of forfeiture. It was only by the forfeiture clause that we could proceed in replevin.

The COURT: But would that show that the copies were found in the possession of the defendant?

By PLAINTIFF'S COUNSEL: Yes, it does so show, because the judgment so recites. I will read the judgment to your Honor.

The COURT: Supposing it does; in replevin the judgment is on the plaintiff's title; and the plaintiff, according to the judgment, recovers the things belonging to him, the copies, and dies and all that; those would be his. But is it within the province of a suit for the replevin of property to determine what the statute says: "forfeit so much as is found in the possession of the defendant?"

By PLAINTIFF'S COUNSEL: Yes, your Honor will find that is exactly what was tried and what was proved in the action, and it appears from the judgment.

The COURT: The plaintiff might be entitled to that property and still the sheets not to be found, in the sense of this statute, in the possession of the defendant. Have you not got to show otherwise the actual finding?

By PLAINTIFF'S COUNSEL: We have to show, and we had
24 to show in the replevin action, in order to recover anything that the writ of replevin was issued at the commencement of the action, and that a writ of replevin had been executed by the Marshal, and that the sheets had been found by the Marshal and had been replevied by the Marshal; that they were in Court, or ready to be produced and we had to give evidence of the number of sheets which the Marshal found under the writ of replevin, and it was under that evidence that finally we obtained a judgment and I will read your Honor the judgment because I have not so far explained what the judgment was.

The COURT: You say it recites that they found these with the defendant?

By PLAINTIFF'S COUNSEL: Yes, and that was proved, and it was only upon proof that we got our judgment, only on that proof.

The COURT: But that judgment would be that they would become yours—forfeited to you.

By PLAINTIFF'S COUNSEL: Yes.

The COURT: Without taking any view at all as to the effect to be

given to the judgment in this proceeding, is there any reason why it should not be taken into the record?

Mr. JENNER: I have other grounds of objection which I desire to put upon the record.

The COURT: What are they?

Mr. JENNER: There are several of them. I object to the offer of the judgment roll on the ground that the judgment is not between the same parties. The judgment roll itself of the former action shows that it was between Werckmeiser and The American Tobacco Company solely. The present action is between Werckmeister, as plaintiff, and also the United States of America as plaintiffs.

Mr. KNAUTH: Oh, no.

The COURT: *Qui tam.*

25 Mr. JENNER: *Qui tam.* The United States of America is as much interested in the action as Werckmeister. Any recovery which the plaintiff may obtain in the action inures equally to the benefit of both, and the Government cannot come in under the skirts of a judgment obtained in the former action by Werckmeister and enjoy its half of any penalties that may be recovered, without violating all the rules on which judgments are allowed to estop the parties to them.

I also object to the judgment roll on the ground that in order to be competent the same questions must have been litigated in the former action. In this action the defendant can be held to a penalty only upon proof that it has either engraved, etched, worked, copied, printed, published, dramatized, translated or imported, either in whole or in part, by varying the main design, or knowing the same to be so printed, published, dramatized, translated or imported, shall sell or expose to sale. The defendant cannot, I repeat, be held unless one or other of those things is proved against the defendant; and when one or other of those things is proved against the defendant, then the defendant may become liable for those copies which are found in its possession, whatever that may mean, or which it has sold or exposed for sale. The plaintiff in this case—or the plaintiffs, rather, in this case—must prove one or the other of those things as the foundation of recovery. None of those things was proved in the former action and none of those questions was in issue in the former action, as appears by the pleadings themselves and by the judgment; and that consideration alone must rule out that judgment.

I object to the judgment roll on the further ground that the replevin which was established in it was an illegal action; that

26 the Marshal had no authority to seize the goods, under the statute or at common law; that replevin was an unwarranted and an unauthorized proceeding by any law of the United States, and hence the seizure by the Marshal was illegal and was an invasion of the constitutional rights of the defendant, under the Fourth and Fifth Constitutional Amendments.

The COURT: My present idea is to take all this record into this case. It shows that there was such a suit and that there was such a thing done in it; but I am not now holding that that is in any wise conclusive on the defendant in this case as to making out a case for

this forfeiture; but I will take it in, and it will be necessary in order to raise the point you last make, to show that there had been a verdict in another case, for what you say is this same thing.

The papers in one package are marked "Exhibit B."

[Plaintiff rests.]

Defendant's counsel states that he will offer no evidence and moves to dismiss the complaint, or for the direction of a verdict.

By PLAINTIFF'S COUNSEL: We claim $10 for each copy of the picture in question which was found by the Marshal to have been in the defendant's possession at the time when the two writs of replevin in the first action were executed. In connection with that I read to your Honor the clause of the judgment itself.

The judgment says:

"It is adjudged that the plaintiff have and retain and is entitled to the possession of 1196 sheets, each containing a copy of the
27 plaintiff's copyright picture "Chorus," found in the possession of the defendant and replevied by the United States Marshal, all as alleged in the plaintiff's complaint, said sheets having been made in violation of plaintiff's copyright, and that the same are forfeited by the plaintiff, and are of the value of $1,010."

This is the clause of the judgment in the first action in the replevin action. Of course, under the statute we will have to confine ourselves to asking penalty on a number of 1,000 copies, because the outside limit of the penalty, as stated in the statute, is $10,000, and making a penalty of $10 for each sheet, we can claim in this action only the penalty of 1,000 of those sheets and ask the penalty of $10,000. That is what we have asked in our complaint.

The COURT: It seems to me that you will need to go a little further; while this record shows that such a suit was had, and that certain copies were seized by the Marshal, I do not think that it is included; the question there was whether these copies that the Marshal took and plates, whatever they were—copies, I believe they were—whether they were forfeited to the plaintiff so that the plaintiff owned them; and it was adjudged that he did own them, but the fact that they are found in the possession of the defendant so as to forfeit $10 a piece more, I do not think that was so drawn in that it is conclusive of that forfeiture. I think you ought to prove more.

By PLAINTIFF'S COUNSEL: Does not your Honor think that the recital of that fact in the judgment, that these copies were found in the possession of the defendant by the Marshal and replevied in that action, should be sufficient proof of that fact?

28 The COURT: No; I don't think so.

The judgment here says: "replevied by the Marshal," but it does not seem to me that the recital of a fact of a replevin by the Marshal proves the essential question of the possession by the defendant, in order to forfeit $10 a piece for these copies. I do not think this goes far enough to make out a conclusive case on which we now can tell the jury that this record shows over 1,000 copies found in the possession of the defendant, and therefore we must direct the Jury that they must find conclusively that they were in the posses-

sion of the defendant. We should not have anything to do here, only to read this thing and enter a judgment.

Plaintiff's counsel offered in evidence the Marshal's return together with the replevin papers attached, both of the 203 copies and the 996 copies which were replevied in Buffalo.

Will your Honor allow me to offer the Marshal's return, together with the papers attached?

The COURT: Yes.

Plaintiff's Counsel offers in evidence the return of the Marshal of this Court dated June 23, 1902, in an action between these parties on a writ of replevin; to which is attached an undertaking, summons, a writ of replevin, affidavit and specimens of the picture in question; all entitled in the action of this plaintiff against this defendant, in this Court, in replevin. Also the return of the Marshal, William R. Compton, United States Marshal for the Western District of New York, in which he certifies having replevied, on June 29, 1902, at Buffalo, 993 pictures entitled "Chorus," with specimens thereof attached to his return, and an undertaking, writ of
29 replevin, and affidavit, all attached to the Marshal's return in the action of replevin.

Defendant's counsel objects to both papers on the ground that they are incompetent, irrelevant and immaterial.

The COURT: The defendant had rested, but we permitted this to be offered now, and exclude it as immaterial.

Exception by plaintiff.

By direction of the Court the jury rendered a verdict in favor of the defendant.

Exception by plaintiff.

Plaintiff's counsel moves on the record for a verdict in favor of the plaintiff.

Motion denied; exception by plaintiff.

Plaintiff's counsel moves to set aside the verdict as being against the evidence and against the law.

A motion having been subsequently been made herein and argued, the Court denied the motion and filed the following opinion. (See page 33.)

On motion a stay of sixty days after entry of the judgment was granted to the plaintiff.

The foregoing bill of exceptions contains all of the evidence and testimony in any way material to the exceptions sought to be reviewed.

And inasmuch as said matter produced and offered in evidence on the trial, and the said exceptions so made to the rulings and decisions of the said Judge, do appear upon the record of the said case, in the Circuit Court of the United States, for the Southern District of New York, the defendant has procured and caused to be settled this bill of exceptions as a record thereof in accordance with the statute in such cases made and provided, and the Court hereby
30 signs and orders this bill of exceptions to be filed this 15th day of June, in the year one thousand nine hundred and five.

HOYT H. WHEELER, *Judge.*

We hereby consent to the settlement and filing of the above bill of exceptions.

Dated New York, June 12th, 1905.

BRIESEN & KNAUTH,
Attorneys for Plaintiff,
WETMORE & JENNER,
Attorneys for Defendant.

PLAINTIFF'S EXHIBIT A. DECEMBER 12, 1904. F. M. A.

United States Circuit Court, Southern District of New York.

Action No. 2.

EMIL WERCKMEISTER, Suing for Himself and the United States,
against
AMERICAN TOBACCO COMPANY.

To the above-named Defendant:

You are hereby summoned to answer the complaint in this action and to serve a copy of your answer on the plaintiff's attorneys within twenty days after the service of this summons, exclusive of
31 the day of service; and in case of your failure to appear, or answer, judgment will be taken against you by default for the relief demanded in the complaint.

Witness, the Honorable Melville W. Fuller, Chief Justice of the United States, at the Borough of Manhattan, in the City of New York, this 17th day of July, in the year one thousand nine hundred and three.

[SEAL.] JOHN A. SHIELDS, *Clerk.*

BRIESEN & KNAUTH,
Plaintiff's Attorneys.

Office and Post Office Address, 49 Wall Street, Borough of Manhattan, New York City.

PLAINTIFF'S EXHIBIT B. DECEMBER 12, 1904. F. M. A.

United States Circuit Court, Southern District of New York.

Action No. 1.

EMIL WERCKMEISTER
against
AMERICAN TOBACCO COMPANY.

(Replevin.)

To the above-named Defendant.

You are hereby summoned to answer the complaint in this action and to serve a copy of your answer on the plaintiff's attorneys within

twenty days after the service of this summons, exclusive of the day of service; and in case of your failure to appear, or answer,
32 judgment will be taken against you by default for the relief demanded in the complaint.

Witness, the Honorable Melville W. Fuller, Chief Justice of the United States, at the Borough of Manhattan in the City of New York, this 20th day of June, in the year one thousand nine hundred and two.

[SEAL.] JOHN A. SHIELDS, *Clerk.*

BRIESEN & KNAUTH,
Plaintiff's Attorneys.

Office and Post Office Address, 49 Wall Street, Borough of Manhattan, New York City.

Circuit Court of the United States for the Southern District of New York.

EMIL WERCKMEISTER, Plaintiff,
against
AMERICAN TOBACCO COMPANY, Defendant.

The amended complaint of the above-named against the above-named defendant, respectfully shows to this Court, upon information and belief:

First. That said plaintiff during the times hereinafter stated was and is a citizen of the German Empire, doing business at the
33 City of Berlin, in Germany, under the trade name of "Photographische Gesellschaft," and at the City of New York in the United States, under the name of the "Berlin Photographic Company."

Denied.

Second. That said defendant is a corporation duly incorporated under the laws of the State of New Jersey, having a place of business in the Borough of Manhattan, in the County and State of New York, in the Southern District of New York.

Admitted.

Third. That shortly previous to the second day of April, 1894, one W. Dendy Sadler, a British subject, invented, designed and painted a certain painting called "Chorus," said painting showing a group of gentlemen sitting and standing around a punch bowl and holding pipes and filled glasses in their hands and singing in chorus, and said painting by reason of its artistic grouping, its excellent drawing of the figures and faces, and the skillful execution, is a piece of art of very great merit and value.

Denied.

Fourth. That the said W. Dendy Sadler on or about the second day of April, 1894, by an instrument in writing executed and delivered on the said day, and previous to any publication of said painting in any manner or form, assigned, transferred and sold to

said plaintiff for a valuable consideration, all his right, title and interest in any copyright obtainable thereon in the United States of America, and in all other countries, and the sole liberty and right
of printing and reprinting, publishing, completing, copying,
34 executing, finishing and vending said painting.

Denied.

Fifth. That having acquired the right to obtain such copyright for said painting, and being a subject of the Emperor of Germany, and desiring to secure the copyright thereof under the laws of the United States of America respecting copyrights, and the sole right of printing and reprinting, publishing, completing, copying, executing, finishing and vending the same, said plaintiff before the publication thereof in this or any foreign country, to wit, on the sixteenth day of April, 1894, delivered to the Librarian of Congress at his office at Washington, District of Columbia, a description of said painting, to wit, "Chorus"—W. Dendy Sadler, "A Company of Gentlemen with filled glasses singing in Chorus," and also a photograph thereof, and at the same time said plaintiff pa-d to the said Librarian of Congress the sum of one dollar ($1.00) for recording said description and thereupon said Librarian of Congress duly received the same and recorded said description of said painting on the sixteenth day of April, 1894.

Denied.

Sixth. That thereafter, on or about the first day of June, 1894, and not before, said plaintiff began the publication of said painting in this country and in foreign countries, by the sale of copies thereof.

Denied.

Seventh. That by reason of the premises and the statutes in such cases made and provided there was secured to said plaintiff, his executors, administrators and assigns, or intended so to be,
35 for the term of twenty-eight (28) years from said sixteenth day of April, 1894, the sole liberty of printing and reprinting, publishing, completing, copying, executing, finishing and vending the said painting "Chorus."

Denied.

Eighth. That said plaintiff has duly given notice of his copyright as is required by law, by inscribing upon a visible portion of every copy of said painting published by him, or of the substance on which the same were mounted, the word "Copyright," together with the year the copyright was entered, and the name of the party by whom it was taken out, thus: "Copyright, 1894, by Photographische Gesellschaft."

Denied.

Ninth. That at the time of the commencement of this action said defendant was and still is in possession at its office No. 111 Fifth avenue, New York City, and at its factory building in said city, and in the hands of its various agents, officers and employees in said State of 7,338 sheets, each containing a copy of said copyrighted painting prepared in violation of plaintiff's copyright wrongfully and without the consent of said plaintiff, the proprietor of said copyright

first obtained in writing signed in the presence of two witnesses; that said defendant caused said copies to be printed for it by the American Lithographic Company and upon delivery thereof to defendant, *published some* of said sheets in the City of New York and elsewhere in the United States of America; that said unlawful printing and publication of said copies in defendant's possession was done before the commencement of this action, and within one year
36 previous thereto, and during the existence of said copyright; and that 203 of said copies in the defendant's possession as aforesaid, were, at the commencement of this action, seized by the Marshal of this Court under a writ of replevin duly issued out of this Court and are now in the hands of said Marshal or of the Clerk of this Court in pursuance of said writ duly executed.

That nine hundred and ninety-three (993) of said copies in defendant's possession at the place of business of the Deuther Manufacturing Company in the City of Buffalo, New York, were, after the commencement of this action, seized by the United States Marshal for the Western District of New York, under a writ of replevin duly issued out of this Court, and are now in the hands of said Marshal in pursuance to said writ duly executed.

Denied.

Tenth. That by virtue of the statutes of the United States, every one of said copies of said painting found in the possession of said defendant as aforesaid, or which may hereafter be found in its possession, has become and will be forfeited to said plaintiff, and is, and they now are his property.

Denied.

Eleventh. That the same are wrongfully detained by said defendant.

Denied.

Wherefore, said plaintiff demands judgment against said defendant for the delivery to him, said plaintiff, of all said copies of said painting, "Chorus," made in violation of said plaintiff's copyright thereon, and found in the possession of said defendant, and of all such further copies made in violation of plaintiff's said copyright, as may be found in said defendant's possession previous
37 to the trial of this action together with the costs of this action.

BRIESEN & KNAUTH,
Plaintiff's Attorneys.

No. 49 Wall Street, New York City.

SOUTHERN DISTRICT OF NEW YORK,
State of New York, County of New York, ss:

Antonio Knauth, being duly sworn, deposes and says:

That he is one of the attorneys for the plaintiff in the foregoing amended complaint; that he has read said amended complaint and knows the contents thereof, and that the same is true except only the allegations therein stated to be on information and belief, and that as to those allegations he believes it to be true. Deponent further says that the reason why this verification is not made by said

plaintiff is that said plaintiff is not in this country, but is a resident of Berlin in the Empire of Germany, and not at present in this country and capable of making this affidavit; and that the sources of deponent's information, and the grounds of his belief concerning the matters stated to be alleged on information and belief in said amended complaint, are the possession of the certificate of the copyright referred to in said complaint issued by the Librarian of Congress, correspondence and personal interviews with the plaintiff, correspondence with the defendant and its attorney, and the personal examination of the defendant's infringing picture.

ANTONIO KNAUTH.

Sworn to before me this 21st day of December, 1903.

OTTO V. SCHRENK,

[SEAL.] *Notary Public, N. Y. County.*

38 United States Circuit Court, Southern District of New York.

EMIL WERCKMEISTER, Plaintiff,

vs.

AMERICAN TOBACCO COMPANY, Defendant.

The above-named defendant answers the amended complaint of the plaintiff and for answer says:

I. This defendant has no knowledge or information sufficient to form a belief as to any of the matters set forth in the amended complaint of the plaintiff excepting that—

This defendant admits that it is a corporation duly incorporated under the laws of the state of New Jersey, and that it has a place of business in the Borough of Manhattan, in the County and State of New York and Southern District of New York, and excepting that—

This defendant admits that on or about the 26th day of June the defendant had certain lithographed copies of a picture which had been made for the defendant by the American Lithographic Company, and which this defendant now understands and believes is claimed by the plaintiff herein to be an infringement of the alleged copyright mentioned in the amended complaint herein, but how many of such pictures were in the possession of the defendant or its employees this defendant has no knowledge or information sufficient to form a belief and therefore the defendant denies the allega-

39 tions contained in the amended complaint in that behalf, excepting that—

This defendant is informed and believes that certain copies of the said picture were on or about the 26th day of June, 1902, and at the instance and by the procurement of the plaintiff, seized by the Marshal of this Court and were carried away by him, and that the number of copies of said picture so seized and carried away by said Marshal was one hundred and thirteen, and excepting that—

This defendant denies the allegations contained in the tenth and eleventh paragraphs of the amended complaint,

For a further and separate defense referring to the denials, admis-

sions and allegations hereinbefore contained material to this separate defense, with the same force and effect as if the same were here at length repeated, this defendant alleges:

II. Upon information and belief that if any such copyright was obtained by the plaintiff as is set forth in the amended complaint herein, which, however, the defendant does not admit but denies as aforesaid, the same was and is void for the reason that the plaintiff, at the time of taking out the said copyright, was not and never had or has been either the author, inventor, designer or proprietor of the said painting "Chorus" alleged in the amended complaint herein to have been copyrighted, nor the assignee of the author, inventor, designer, or proprietor thereof and had no right or authority under the statute relating to copyrights to take out or obtain any copyright thereon.

For a further and separate defense to the cause of action set forth in the amended complaint, this defendant referring to the
40 denials, admissions and allegations hereinbefore contained material to this separate defense, with the same force and effect as if the same were here at length repeated, alleges upon information and belief as follows:

III. That if any such copyright was obtained by the plaintiff as is set forth in the amended complaint herein, which, however, this defendant does not admit, but denies as aforesaid, the same was and is void and was abandoned to the public and the plaintiff had and has no right to maintain any action for the reason that the said painting "Chorus" alleged in the amended complaint to have been copyrighted was publicly exhibited by the author and proprietor thereof at the exhibition of the Royal Academy of Arts held in the City of London, England, from the first Monday of May, in the year 1894, to the first Monday of August in the same year, both days inclusive, and continuously during said period, and was during the whole of said period exhibited to the public, and published and that there was not at any time during that said exhibition, nor before, nor at any time since, any notice of the said copyright inscribed upon some visible portion of the said painting or on the substance on which the same was mounted, as required by the statute in such case made and provided, and that such exhibition and publication was with the knowledge, consent and permission of the plaintiff and the said Sadler, the author and proprietor of said painting.

Wherefore the defendant demands judgment that the amended complaint be dismissed with costs, that the plaintiff be required to return the copies of said picture so seized by the Marshal of this Court, or the value thereof, and that the defendant have judg-
41 ment against the plaintiff by reason of the damages caused by the taking and detention thereof.

WETMORE & JENNER,
Defendant's Attorney-, 34 Pine Street,
Borough of Manhattan, N. Y. City.

UNITED STATES OF AMERICA, *Southern District of New York, ss:*

Percival S. Hill, being duly sworn, deposes and says:

That the foregoing answer is true of my own knowledge excepting the matters herein stated to be alleged upon information and belief and as to those matters I believe it to be true. That the reason why this verification is not made by the defendant is that the defendant is a corporation; that I am the first vice-president thereof; that my information has been derived from employees of the defendant and from officers and employees of the American Lithographic Company having knowledge or information on the matters set forth in the answer and the statements made to me by such persons are the grounds of my belief.

PERCIVAL S. HILL.

Sworn to and subscribed before me this 22d day of July, 1903.

JOHN J. O'KEEFFE,
Notary Public in and for the County of New York.

42 Circuit Court of the United States for the Southern District of New York.

EMIL WERCKMEISTER, Plaintiff,
vs.
AMERICAN TOBACCO COMPANY, Defendant.

The above-named plaintiff replying to the further and separate defense set out in the paragraphs marked "II" and "III" in the answer to the amended complaint herein respectfully shows to the Court, upon information and belief:

First. He denies each and every allegation contained in said paragraph marked "II" of said answer.

Second. He denies each and every allegation contained in said paragraph marked "III" of said answer.

BRIESEN & KNAUTH,
Attorneys for Plaintiff, 49 Wall Street, New York City.

SOUTHERN DISTRICT OF NEW YORK,
City and County of New York, ss:

Antonio Knauth, being duly sworn, deposes and says: That
43 he is one of the attorneys for the plaintiff herein and acquainted with the facts herein and has personal charge of the action herein; that he has read the foregoing reply and knows the contents thereof and that the same is true to his own knowledge, except as to those allegations therein stated to be alleged upon information and belief and that as to those allegations he believes it to be true. Deponent further says that the reason why this verification is not made by said plaintiff is that said plaintiff is not in this country, but is a resident of Berlin, Germany, and not at present in this country and capable of making this affidavit; that the sources

of deponent's information and the ground of his belief concerning the matters stated to be alleged on information and belief in said reply are the possession of all the original papers in the action, correspondence and interviews with the plaintiff and plaintiff's representatives and with the defendant and defendant's attorney.

ANTONIO KNAUTH.

Sworn to before me this 1st day of October, 1902.

[SEAL.] EUGENE EBLE,
Notary Public, New York County.

44 At a Stated Term of the Circuit Court of the United States of America for the Southern District of New York, in the Second Circuit, held at the United States Court Rooms in the Borough of Manhattan, in the City of New York, on Tuesday, the 22d day of November, in the year of our Lord one thousand nine — and four.

Present: The Honorable William K. Townsend, Circuit Judge.

EMIL WERCKMEISTER
vs.
AMERICAN TOBACCO COMPANY.

Now comes the plaintiff by Antonio Knauth, Esq., his attorney, and moves the trial of this cause. Likewise comes the defendant by William A. Jenner, Esq., its attorney. Thereupon a jury is impaneled and the cause proceeds to trial.

After hearing the evidence for the plaintiff and the argument of counsel the jury by direction of the Court find a verdict in favor of the plaintiff.

Thereupon Mr. Jenner moves to set the verdict aside and for a new trial.

Denied.

Stay of 60 days after entry of judgment within which to make and serve a case with leave to turn the same into a bill of exceptions.

Granted to defendant.

45 Thereupon on Friday, November 25, 1904, Mr. Jenner, defendant's counsel, moves for a new trial and to set the verdict aside.

Denied.

An extract from the minutes.

[SEAL.] JOHN A. SHIELDS, *Clerk.*

U. S. Circuit Court, Southern District of New York.

EMIL WERCKMEISTER, Plaintiff,
vs.
AMERICAN TOBACCO COMPANY, Defendant.

Writ of Replevin, &c.

By virtue of the annexed affidavit and writ of replevin I did on Monday, the 23d day of June, 1902, replevy in the premises of the above-named defendant, American Tobacco Company, in Room 28, 3d floor, at No. 111 Fifth avenue, Borough of Manhattan, City of New York, in my district, the following property: Two hundred and three (203) pictures called "Chorus," of which seven (7) are hereto annexed, being a part of the property and chattels described in said affidavit and writ.

After diligent search the remainder of the property described in said affidavit could not be found.

I further return that at the same time and place I served
46 without delay the annexed summons, writ of replevin, affidavit of Emil Werckmeister, dated June 20, 1902, and undertaking, together with a copy of exhibit hereto annexed marked "A," upon the above-named defendant, American Tobacco Company, by delivering true copies of each thereof to James B. Duke, president of said company, and at the same time exhibiting to him the within originals and the signatures thereon and leaving with him said copies thereof.

WILLIAM HENKEL,
U. S. Marshal, S. D. N. Y.

Dated New York, June 23d, 1902.

United States Circuit Court, Southern District of New York.

EMIL WERCKMEISTER, Plaintiff,
against
AMERICAN TOBACCO COMPANY, Defendant.

Undertaking to Secure Costs — Non-resident Plaintiff, &c.

Whereas, Emil Werckmeister, the above-named plaintiff, has commenced an action in the above-named Court against American Tobacco Company, the above-named defendant.

Now, therefore, we, Theodore Rogers of Jamaica, Queens Borough, in the City of New York, and Edward C. Evans, of No. 221 West One Hundred and Twenty-ninth street, in the City of New
47 York, Borough of Manhattan, do hereby pursuant to the statute in such case made and provided, jointly and severally undertake that we will pay, upon demand, to the defendant, all costs

which may be awarded to it in said action, not exceeding the sum of two hundred and fifty dollars.

Dated New York, June 20, 1902.

THEO. ROGERS.
EDWARD C. EVANS.

STATE AND COUNTY OF NEW YORK, *ss:*

Theodore Rogers, being sworn, says: That he is a resident of and a freeholder within the State of New York, and worth double the sum specified in the above undertaking over all the debts and liabilities which he owes or has incurred, and exclusive of property exempt by law from levy and sale under an execution.

THEO. ROGERS.

Sworn to before me this 20th day of June, 1902.
[SEAL.]
OTTO v. SCHRENK,
Notary Public, N. Y. County.

STATE AND COUNTY OF NEW YORK, *ss:*

Edward C. Evans, being sworn, says: That he is a resident of and a freeholder within the State of New York, and worth double the sum specified in the above undertaking over and above all the debts and liabilities which he owes or has incurred, and exclusive of property exempt by law from levy and sale under an execution.

EDWARD C. EVANS.

Sworn to before me this 20th day of June, 1902.
[SEAL.]
OTTO v. SCHRENK,
Notary Public, N. Y. County.

48 STATE AND COUNTY OF NEW YORK, *ss:*

I certify that on this 20th day of June, 1902, before me personally appeared the within named Theodore Rogers and Edward C. Evans, to me known, and known to me to be the individuals described in and who executed the within undertaking, and they severally acknowledged to me that they executed the same for the uses and purposes therein mentioned.

[SEAL.]
OTTO v. SCHRENCK,
Notary Public, N. Y. County.

(Endorsed:)—Original.—U. S. Circuit Court.—Southern District of New York.—Emil Werckmeister, plaintiff, against American Tobacco Co., Defendant.—Undertaking to secure costs. Non-resident plaintiff, &c.—Briesen & Knauth, Plaintiff's Attys., 49 Wall St., N. Y.—Approved as to form & sufficiency of sureties.—June 20, 1902.—Geo. B. Adams, U. S. Judge.

United States Circuit Court, Southern District.

EMIL WERCKMEISTER, Plaintiff,
vs.
AMERICAN TOBACCO COMPANY, Defendant.

Undertaking of Plaintiff in Action to Recover a Chattel.

Whereas, Ludwig Schutze, resident agent of the plaintiff in this action, has made an affidavit that the defendant therein
49 wrongfully detains certain chattels, in the said affidavit mentioned, of the value of one thousand and twenty-five dollars ($1,025.00) and the plaintiff claims the immediate delivery of such property to him, as provided for in chapter fourteen of the Code of Civil Procedure;

Now, therefore, in consideration of the taking of said property, or any part thereof, by the Marshal of the United States for the Southern District of New York, by virtue of the said affidavit and the requisition thereupon endorsed, we, the undersigned, Theodore Rogers of Jamaica, New York City, Queens Borough, State of New York, and Edward C. Evans, of No. 21 West One Hundred and Twenty-ninth street, in the City of New York, Borough of Manhattan, State of New York, do hereby, pursuant to the statute in such case made and provided, jointly and severally undertake and become bound to the defendant in the sum of two thousand and fifty dollars ($2,050.00) for the prosecution of the action by the plaintiff against the defendant for the return of the said chattel to the defendant if possession thereof is adjudged to it, or if the action abates or is discontinued before the said chattels are returned to the said defendant, and for the payment to the defendant of any sum which the judgment awards to him against the plaintiff.

Dated New York, June 20, 1902.

THEO. ROGERS. [L. S.]
EDWARD C. EVANS.

STATE AND COUNTY OF NEW YORK, *ss:*

Theodore Rogers, one of the sureties named in and subscribers to the foregoing undertaking, being duly sworn, says that he is a resident of and a freeholder within the State, and is worth the sum of four thousand one hundred ($4,100) dollars over all the
50 debts and liabilities which he owes or has incurred, and exclusive of property exempt by law from levy and sale under an execution.

THEO. ROGERS.

Sworn to before me the 20th day of June, 1902.
[SEAL.] OTTO v. SCHRENK,
Notary Public, N. Y. County.

STATE AND COUNTY OF NEW YORK, *ss:*

Edward C. Evans, one of the sureties named in and subscribers to the foregoing undertaking, being duly sworn, says that he is a resident of and a freeholder within the State and is worth the sum of four thousand one hundred dollars over all the debts and liabilities which he owes or has incurred, and exclusive of property exempt by law from levy and sale under an execution.

EDWARD C. EVANS.

Sworn to before me this 20th day of June, 1902.

[SEAL.] OTTO v. SCHRENK,
Notary Public, N. Y. County.

STATE AND COUNTY OF NEW YORK, *ss:*

I certify that on this 20th day of June, 1902, before me personally appeared Theodore Rogers and Edward C. Evans, to me known and known to me to be the individuals described in and who executed the within undertaking, and they thereupon severally duly acknowledged to me that they executed the same.

OTTO v. SCHRENK,
Notary Public, N. Y. County.

(Endorsed:) U. S. Circuit Court.—Southern District of New York.—Emil Werckmeister *vs.* American Tobacco Co.—Un-
51 dertaking of plaintiff in replevin.—Briesen & Knauth, Attorneys for Plaintiff, 49 Wall St., N. Y.

I approve of the within undertaking and of the sufficiency of the sureties therein named.—June 20, 1902.—Geo. B. Adams, U. S. Judge.

United States Circuit Court, Southern District of New York.

EMIL WERCKMEISTER, Plaintiff,
vs.
AMERICAN TOBACCO COMPANY, Defendant.

To the Marshal of the United States for the Southern District of New York:

You are hereby requested to replevy the chattels described in the within affidavit.

Witness, Hon. Melville W. Fuller, Chief Justice of the United States, at the United States Court House, in the Borough of Manhattan, City of New York, Southern District of New York, this 20th day of June, 1902.

JOHN A. SHIELDS, *Clerk.*

Allowed,
GEO. B. ADAMS,
U. S. Judge.

BRIESEN & KNAUTH,
Attorneys for Plaintiff, 49 *Wall Street, New York, N. Y.*

52 Circuit Court of the United States, Southern District of New York.

EMIL WERCKMEISTER, Plaintiff,
vs.
AMERICAN TOBACCO COMPANY, Defendant.

SOUTHERN DISTRICT OF NEW YORK,
City and County of New York, ss:

Ludwig H. Schute, being duly sworn, says:

First. That the above-named plaintiff is the owner of the chattels hereinafter particularly described, which are in the possession of the above-named defendant, as hereinafter stated.

Second. That said plaintiff, for many years prior to the year 1894 and ever since said year, has lawfully done business under the name of Photographische Gesellschaft, at Berlin, Germany, and under the name of Berlin Photographic Company, in the United States of America.

Third. That shortly previous to the 2d day of April, 1894, one W. Dendy Sadler invented, designed and painted a certain painting called "Chorus," that said painting shows a group of smokers, sitting and standing around a punch bowl and holding pipes and
53 glasses in their hands, and singing a song, and said painting, by its artistic grouping and expression of the faces and its careful and skillful execution, is a piece of art of very great merit and value.

Fourth. That on or about the 2d day of April, 1894, said W. Dendy Sadler, by an instrument in writing, executed on said day, assigned, transferred and sold to said plaintiff, for a valuable consideration, all his right, title and interest in any copyright obtainable thereon in the United States of America and in all other countries, and the sole liberty and right of printing, reprinting, publishing, completing, copying, executing, finishing and vending said painting.

Fifth. That, having acquired the right to obtain such copyright for such painting, and being a subject of the Emperor of Germany, and desiring to secure the copyright thereof under the laws of the United States of America respecting copyrights, said plaintiff, before the publication thereof in this or any foreign country, to wit: on the 16th day of April, 1894, delivered to the librarian of Congress at his office, at Washington, District of Columbia, a description of said painting, to wit, "Chorus, W. Dendy Sadler, c company of gentlemen with filled glasses, singing in chorus," and also a photograph thereof, and at the same time said plaintiff paid to said Librarian of Congress the sum of one dollar for recording said description, and thereupon said Librarian of Congress duly received the same and recorded said description of said painting on the 16th day of April, 1894, and duly rendered to said plaintiff a copy of said description and of said record, under the seal of his office.

54 Sixth. That thereafter, on or about the 1st day of June, 1894, said plaintiff began the publication of said painting in

this country and in foreign countries, and has ever since prepared and sold copies of said painting, made by photogravure process and otherwise.

Seventh. That by reason of the premises and the statutes, in such cases made and provided, there was secured to said plaintiff, his executors, administrators and assigns, or intended so to be, for the term of twenty-eight years from the said 16th day of April, 1894, the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing and vending the said painting, "Chorus."

Eighth. That said plaintiff has duly given notice of his copyright, as is required by law, by inscribing upon a visible portion of every copy of said painting published by him the word "Copyright," together with the year the copyright was entered and the name of the party by whom it was taken out, thus: "Copyright, 1894, by Photographische Gesellschaft."

Ninth. On information and belief that said defendant is in possession, at its offices, No. 111 Fifth Avenue, New York City, and at its factory building, in said city, of twenty-five thousand (25,000) copies of said copyrighted painting, prepared in violation of plaintiff's copyright, by some form of lithographic process, in colors, and which were made at said defendant's directions by the American Lithographic Company, of New York City, wrongfully and without the consent of said plaintiff, the proprietor of said copyright first obtained in writing, signed in the presence of two witnesses;
55 that said unlawful printing of said copies in defendant's possession was done before the commencement of this action and within one year previous thereto, and during the existence of said copyright.

Tenth. That by virtue of the statutes of the United States every one of said twenty-five thousand copies of said painting in the possession of said defendant, as aforesaid, has become forfeited to the plaintiff, and is and they now are his property.

Eleventh. That the same are wrongfully detained by defendant.

Twelfth. That the alleged cause of the detention thereof, according to best knowledge, information and belief of deponent, is that the defendant claims that plaintiff's copyright upon said painting, "Chorus," is not valid, and said painting "Chorus," can be freely copied or cause to be copied by said defendant.

Thirteenth. That said chattels have not been taken by virtue of a warrant against the plaintiff for the collection of a tax, assessment or fine, issued in pursuance of a statute of the State, or of the United States.

Fourteenth. That they have not been seized by virtue of an execution or warrant of attachment against the property of the plaintiff or of any person from or through whom the plaintiff has derived title to the chattels since the seizure thereof.

Fifteenth. That the actual value of said property, as deponent is informed and believes, is one thousand and twenty-five ($1,025) dollars.

56 Sixteenth. The deponent, for eight and one-half years past, has been and is now the agent for said plaintiff, residing at

Exhibit A. 169

Copyright, 1894, by Photographische Gesellsch

the City of New York, and has managed and conducted said plaintiff's business of selling copies of said copyrighted painting, "Chorus," in the United States of America amongst others, and still continues so to do; that said plaintiff is a resident of the city of Berlin, Germany, and not at present in this country, and unable to make this affidavit; that deponent, a few months ago, was informed by one of the officers of said defendant that said defendant intended to put upon the market, for exhibition, in connection with defendant's goods, copies of said copyrighted painting, and within a week from the date thereof he has seen such copies, made under the direction of defendant and exposed to view in public places; that said copies were of a size of about one and one-half feet by two feet and in colors; that a half-tone copy of said painting, "Chorus," made by plaintiff on a small scale for catalogue purposes, is hereto annexed for identification, marked "Exhibit A;" that deponent is in possession of plaintiff's Certificate of Copyright for said painting, "Chorus," and the sources of his information, as to all matters stated hereinbefore to be alleged on information and belief, and the grounds of his belief, are correspondence with the defendant's officers and with the American Lithographic Company, and personal inquiries of deponent.

LUDWIG H. SCHUTZE.

Sworn to before me this 20th day of June, 1902.
[SEAL.]
OTTO v. SCHRENK,
Notary Public, New York County.

(Here follows Exhibit A, marked p. 57.)

58 (Endorsed:) United States Circuit Court, Southern District of New York.—Emil Werckmeister *vs.* American Tobacco Co.—Affidavit of Replevin.—Briesen & Knauth, Attorneys for Plaintiff, 49 Wall Street, Borough of Manhattan, New York.—U. S. Circuit Court, Southern District of New York.—Filed June 23, 1902, John A. Shields, Clerk.

United States Circuit Court, Southern District of New York.

EMIL WERKMEISTER, Plaintiff,
against
AMERICAN TOBACCO COMPANY, Defendant.

Undertaking of Plaintiff in Action to Recover a Chattel.

Whereas, Ludwig H. Schutze, manager of the plaintiff in this action, has made an affidavit that the defendant therein wrongly detains certain chattels, in the said affidavit mentioned, of the value of fifty 50/100 ($50.50) dollars, and the plaintiff claims the immediate delivery of such property to him.

Now, therefore, in consideration of the taking of said property, or any part thereof, by virtue of the said affidavit and the requisition thereupon endorsed, the Lawyers' Surety Company of New York, having an office and principal place of business at Nos. 32, 34
59 and 36 Liberty street, in the City of New York, does hereby, pursuant to the Statute in such case made and provided, undertake and become bound to the defendant in the sum of one hundred and one dollars for the prosecution of the action by the plaintiff against the defendant, for the return of the said chattels to the defendant, if possession thereof is adjudged to it, or if the action abates or is discontinued before the said chattels are returned to the said defendant; and for the payment to the defendant of any sum which the judgment awards to it against the plaintiff.

Dated New York, July 21st, 1902.

THE LAWYERS' SURETY COMPANY
OF NEW YORK,
[SEAL.] By SYLVESTER J. O'SULLIVAN,
Second Vice-President.

Attest:
LOUIS E. KUSTER,
Acting Secretary.

At a stated meeting of the Board of Directors of the Lawyers' Surety Company of New York, held at the office of the company, Nos. 32, 34 and 36 Liberty street, in the said city, on the 21st day of April, 1897, on motion, it was unanimously

"*Resolved*, That the President, the Vice-President, the Acting President, or the Second Vice-President be, and either of them is, hereby authorized and empowered to sign, execute and deliver any and all bonds or undertakings for or on behalf of the company, and

to attach thereto the seal of the Corporation, the same to be attested by the Secretary or the Acting Secretary."

COUNTY OF NEW YORK, *ss:*

I, Louis E. Kuster, Acting Secretary of the Lawyers' Surety Company of New York, have compared the foregoing resolution
60 with the original thereof, as recorded in the Minute Book of said Company, and do hereby certify that the same is a true and correct transcript therefrom, and of the whole of said original resolution.

Given under my hand and the seal of the Company at the City of New York, this 21st day of July, 1902.

LOUIS E. KUSTER,
[SEAL.] *Acting Secretary.*

COUNTY OF NEW YORK, *ss:*

On this 21st day of July, 1902, before me personally appeared Sylvester J. O'Sullivan, Second Vice-President of the Lawyers' Surety Company of New York, with whom I am personally acquainted, who, being by me duly sworn, said: that he resides in the City of New York; that he is the Second Vice-President of the Lawyers' Surety Company of New York, the corporation described in and which executed the above instrument; that he knows the corporate seal of said Company; that the seal affixed to the within instrument is such corporate seal; that it was affixed by order of the Board of Directors of said Company, and that he signed said instrument as Second Vice-President of said Company by like authority, and that the liabilities of said company do not exceed its assets, as ascertained in a manner provided in Section 3, Chapter 720 of the New York Session Laws of 1893. And the said Sylvester J. O'Sullivan further said that he is acquainted with Louis E. Kuster and knows him to be the Acting Secretary of said Company; that the signature of the said Louis E. Kuster, subscribed to the said instrument, is in the genuine handwriting of the said Louis E. Kuster, and was thereto
61 subscribed by the like order of the said Board of Directors and in the presence of him, the said Sylvester J. O'Sullivan, Second Vice-President.

H. G. HINTON,
[SEAL.] *Notary Public, Kings County.*

Certificate Filed in New York County.

SIR: Take notice that the within is a copy of an undertaking entered in this cause and filed in the office of the clerk of this Court on the 23d day of July, 1902.

Dated, New York, July 23, 1902.

Yours, BRIESEN & KNAUTH,
Attorneys for Plaintiff.

American Tobacco Company, Defendant.

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(Endorsed:) U. S. Circuit Court, Southern District of New York.—Emil Werckmeister, against American Tobacco Company.—Undertaking of Plaintiff in Replevin.—Surety: The Lawyers' Surety Company.—Briesen & Knauth, Attorneys for Plaintiff, 49 Wall Street, New York.—Approved as to Form and Sufficiency of Sureties.—July 23, 1902.—E. H. Lacombe, U. S. Circuit Judge.

62 United States Circuit Court, Southern District of New York.

EMIL WERCKMEISTER, Plaintiff,
vs.
AMERICAN TOBACCO COMPANY, Defendant.

To the Marshal of the United States for the Western District of New York:

You are hereby requested to replevy the chattels described in the within affidavit.

Witness, Hon. Melville W. Fuller, Chief Justice of the United States, at the United States Court House, in the Borough of Manhattan, City of New York, Southern District of New York, this 23d day of July, 1902.

[SEAL.] JOHN A. SHIELDS, *Clerk.*

Allowed,
E. H. LACOMBE,
U. S. Judge.

BRIESEN & KNAUTH,
Attorneys for Plaintiff.
49 Wall Street, New York, N. Y.

63 Circuit Court of the United States, Southern District of New York.

EMIL WERCKMEISTER, Plaintiff,
vs.
AMERICAN TOBACCO COMPANY, Defendant.

SOUTHERN DISTRICT OF NEW YORK,
City and County of New York:

Ludwig H. Schultze, being duly sworn, says:

First. That the above-named plaintiff is the owner of the chattels hereinafter particularly described, which are in the possession of the above-named defendant, as hereinafter stated.

Second. That said plaintiff, for many years prior to the year 1904, and ever since said year, has lawfully done business under the name of Photographische Gesellschaft, at Berlin, Germany, and under the name of Berlin Photographic Company, in the United States of America.

Third. That shortly previous to the 2d day of April, 1894, one W. Dendy Sadler invented, designed and painted a certain painting called "Chorus," that said painting shows a group of smokers, sitting and standing around a punch bowl and holding pipes and glasses in their hands, and singing a song, and said painting by its
64 artistic grouping and expression of the faces, and its careful and skillful execution, is a piece of art of very great merit and value.

Fourth. That on or about the 2d day of April, 1894, said W. Dendy Sadler, by an instrument in writing, executed on said day, assigned, transferred and sold to said plaintiff, for a valuable consideration, all his right, title and interest in any copyright obtainable thereon in the United States of America and in all other countries, and the sole liberty and right of printing, reprinting, publishing, completing, copying, executing, finishing and vending said painting.

Fifth. That having acquired the right to obtain such copyright for such painting, and being a subject of the Emperor of Germany, and desiring to secure the copyright thereof under the laws of the United States of America, respecting copyrights, said plaintiff, before the publication thereof in this or any foreign country, to wit: on the 16th day of April, 1894, delivered to the Librarian of Congress, at his office, at Washington, District of Columbia, a description of said painting, to wit: "Chorus," W. Dendy Sadler, a company of gentlemen with filled glasses singing in chorus," and also a photograph thereof, and at the same time said plaintiff paid to said Librarian of Congress the sum of one dollar for recording said description and thereupon said Librarian of Congress duly received the same and recorded said description of said painting on the 16th day of April, 1894, and duly rendered to said plaintiff a copy of said description and of said record under the seal of his office.

65 Sixth. That thereafter, on or about the 1st day of June, 1894, said plaintiff began the publication of said painting in this country and in foreign countries, and has ever since prepared and sold copies of said painting made by photogravure process and otherwise.

Seventh. That by reason of the premises and the statutes in such cases made and provided, there was secured to said plaintiff, his executors, administrators and assigns, or intended so to be, for the term of twetny-eight years from the said 16th day of April, the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing and vending, the said painting, "Chorus."

Eighth. That said plaintiff has duly given notice of his copyright, as is required by law, by inscribing upon a visible portion of every copy of said painting published by him the word "Copyright," together with the year the copyright was entered and the name of the party to whom it was taken out, thus: "Copyright, 1894, by Photographische Gesellschaft."

Ninth. On information and belief, that said defendant is in possession, at the place of business of the Deuther Manufacturing Company, No. — in the City of Buffalo, of one thousand and ten (1,010) sheets containing copies of said copyrighted painting, prepared in

violation of plaintiff's copyright by some form of lithographic process, in colors, and which were made and sent to the Deuther Manufacturing Company at the direction and request of said American Lithographic Company, wrongfully and without the con-
66 sent of said plaintiff, the proprietor of said copyright, first obtained in writing, signed in the presence of two witnesses; that said unlawful printing of said copies in the possession of the Deuther Manufacturing Company was done before the commencement of this action, and within one year previous thereto and during the existence of said copyright.

Tenth. That by virtue of the Statutes of the United States, every one of said one thousand and ten (1,010) copies of said painting in the possession of said defendant, as aforesaid, has become forfeited to the plaintiff, and is, and they now are, his property.

Eleventh. That the same are wrongfully detained by defendant.

Twelfth. That the alleged cause of the detention thereof, according to the best knowledge, information and belief of deponent, is that the defendant claims that plaintiff's copyright upon said painting, "Chorus," is not valid, and said painting, "Chorus," can be freely copied or caused to be copied by said defendant.

Thirteenth. That said chattels have not been taken by virtue of a warrant against the plaintiff for the collection of a tax, assessment or fine, issued in pursuance of a Statute of the State or of the United States.

Fourteenth. That they have not been seized by virtue of an execution or warrant of attachment against the property of the plaintiff, or of any person from or through whom the plaintiff has derived title to the chattels since the seizure thereof.

67 Fifteenth. That the actual value of said property, as deponent is informed and believes, is fifty dollars and fifty cents ($50.50).

Sixteenth. That deponent, for eight and one-half years past, has been and is now the agent for said plaintiff, residing at the City of New York, and has managed and conducted said plaintiff's business of selling copies of said copyrighted painting, "Chorus," in the United States of America amongst others, and still continues so to do; that said plaintiff is a resident of the City of Berlin, Germany, and not at present in this country, and unable to make this affidavit; that suits have been instituted on behalf of the above-named plaintiff against the American Lithographic Company, and also against the above-named defendant, for printing and publishing sheets containing copies of the painting, "Chorus," herein complained of, and to recover such copies; that a writ of replevin was issued in this action, under which 203 infringing copies of the painting, "Chorus," were seized by the U. S. Marshal for the Southern District of New York; that at that time one of the officers of the defendant delivered to deponent a statement showing the number of copies of said infringing lithograph which had been ordered by said American Tobacco Company, and also in what manner some of the copies of said picture had been disposed of. Said statement contained the following item: "Now on hand at Deuther Manufacturing Company for framing

1,010 lettered;" that said Deuther Manufacturing Company is a manufacturer of frames at Buffalo, N. Y., and, as deponent is informed and believes, said 1,010 copies are still in possession of the Deuther Manufacturing Company; that deponent has seen said sheets, containing copies of said copyrighted painting, taken
68 by the U. S. Marshal for the Southern District of New York in the above entitled action, and that he is informed and believes that the sheets containing copies of said copyrighted painting, now in the possession of the De Deuther Manufacturing Company, are in all respects like the copies heretofore taken from the American Tobacco Company; that said copies are of a size of about 1¾ ft. x 2¼ ft., and are in colors; that a half-tone copy of said painting, "Chorus," made by plaintiff on a small scale for catalogue purposes, is hereto annexed for identification, marked "Exhibit A;" that deponent is in possession of plaintiff's Certificate of Copyright for said painting, "Chorus," and the sources of his information as to all matters stated hereinbefore to be alleged on information and belief, and the grounds for his belief are correspondence with the officers of the American Tobacco Company and with the American Lithographic Company, and personal inquiries made by deponent.

LUDWIG H. SCHUTZE.

Sworn to before me this 19th day of July, 1902.

[SEAL.] OTTO v. SCHRENK,
Notary Public, New York County.

69

EXHIBIT A.

(Same as Exhibit A, page 27 of this record.)

70 (Endorsed:) United States Circuit Court, Southern District of New York.—Emil Werckmeister, *vs.* American Tobacco Company.—Affidavit and Writ of Replevin.—Briesen & Knauth, Att'y for Pl'ff, 49–51 Wall Street, Borough of Manhattan, New York. In pursuance of the within Writ of Replevin, I have this 29th day of July, 1902, at Buffalo, N. Y. Replevied at the place of the Deuther Manufacturing Company, at Buffalo, N. Y., 993 pictures, entitled "Chorus," as described in Exhibit "A," and now have the same in my possession and custody. William R. Compton, U. S. Marshal, W. Dist. of N. Y. By Chs. T. Strum, Deputy.—U. S. Circuit Court, Southern District of New York.—Filed Aug. 5, 1902.—John A. Shields, Clerk.

United States Circuit Court, Southern District of New York.

EMIL WERCKMEISTER, Plaintiff,
vs.
AMERICAN TOBACCO COMPANY, Defendant.

SIR: Take notice that we shall present a Bill of Costs, of which the annexed is a true copy, to the Clerk of this Court, for adjustment,

at his office, in the Post Office Building, in the City of New
71 York, Borough of Manhattan, on the 2d day of December, 1894, at ten o'clock in the forenoon of that day.

Dated, New York, November 28, 1904.

Yours, etc., BRIESEN & KNAUTH.

To Wetmore & Jenner, Attorneys for Defendant.

United States Circuit Court, Southern District of New York.

EMIL WERCKMEISTER, Plaintiff,
vs.
AMERICAN TOBACCO COMPANY, Defendant.

Bill of Costs.

	Docket fee	$20.00
	Disbursements:	
1902.		
June 23	Paid Clerk filing Praecipe and issuing Summons.	4.45
July 23	Paid Clerk filing Bond, Writ of Replevin, etc....	1.65
	Paid Clerk issuing Writ of Replevin to Marshal of Western District	1.55
72		
1903		
June 25	Paid Clerk entering order amending Complaint.	.55
	Paid Clerk filing Notice of Motion	.20
Oct. 7	Paid Clerk filing Note of Issue	3.00
1902		
June 23	Paid Marshal Serving Summons	2.24
	Paid Marshal executing Writ of Replevin	4.24
July 23	Paid Marshal Western District for executing Replevin, and disbursements	7.30
	Paid Notary Fees	7.25
1902		
July 31	Paid Lawyers' Surety Co. premium on Bond....	10.00
1903		
Aug. 11	Paid Lawyers' Surety Co. premium on bond....	10.00
1904		
Aug. 5	Paid Lawyers' Surety Co. premium on Bond....	10.00
1902		
July 25	Paid telegram to Buffalo	1.87
1904		
Nov. 29	Paid Clerk for copy of extracts from Minutes....	.50
	Paid Clerk taxing costs and entering judgment..	4.50
		$89.30

STATE OF NEW YORK, *County of New York, ss:*

Otto V. Schrenk, being duly sworn, deposes and says: That he is an attorney and counsellor-at-law in the office of Briesen & Knauth, the attorneys for the plaintiff in the above entitled action,
73 and has had charge of said action; that the disbursements above mentioned are reasonable in amount and have actually been made in this action, or will be necessarily incurred therein.

OTTO v. SCHRENK.

Sworn to before me this 30th day of November, 1904.

EUGENE EBLE,
[SEAL.] *Notary Public, New York County.*

Taxed at the sum of $89.30 this 2nd day of December, 1904.

JOHN A. SHIELDS, *Clerk.*

Def't's cou-sel objects to item of 55c. for amt. order and 30 premium on bonds.

J. A. S., *Clerk.*

United States Circuit Court, Southern District of New York.

EMIL WERCKMEISTER, Plaintiff,
vs.
AMERICAN TOBACCO COMPANY, Defendant.

The issues in this action having been brought on for trial before the Hon. William K. Townsend, United States Circuit Judge, and a jury, at a stated term of this Court, held in the court-rooms
74 thereof, in the Post Office Building, in the City of New York, Borough of Manhattan, on the 22d day of November, 1904, and the issues having been tried, and a verdict directed by the Court in favor of the plaintiff;

Now, therefore, and on motion of Brieson & Knauth, the attorneys for the plaintiff, it is

Adjudged that the plaintiff have and retain, and is entitled to the possession of one thousand one hundred and ninety-six (1,196) sheets, each containing a copy of the plaintiff's copyrighted picture, "Chorus," found in the possession of the defendant and replevied by the United States Marshal, all as alleged in plaintiff's complaint, said sheets having been made in violation of plaintiff's copyright, and that the same are forfeited to the plaintiff, and are of the value of one thousand and ten dollars ($1,010); and it is further

Adjudged, that the plaintiff recover from the defendant the sum of eighty-nine 30/100 dollars ($89.30), his costs and disbursements as taxed, and that the plaintiff have execution therefor.

Dated, New York, December 5, 1904.

JOHN A. SHIELDS, *Clerk.*

Approved as to form.

WETMORE & JENNER,
Attorneys for Defendant.

(Endorsed:) U. S. Circuit Court, Southern District of New York.—Filed December 5, 1904. John A. Shields, Clerk.

75 UNITED STATES OF AMERICA,
Southern District of New York, ss:

I, John A. Shields, Clerk of the Circuit Court of the United States in and for the Second Circuit and Southern District of New York,

Do hereby certify that I have compared the preceding with the original Judgment on file and of record in my office, and that the same is true and correct transcript therefrom, and of the whole of said original.

In testimony whereof, I have hereunto set my hand and affixed the seal of said Court, at the City of New York, in the District and Circuit above-named, this 5th day of December, in the year of our Lord one thousand nine hundred and four, and of the Independence of the United States the one hundred and twenty-ninth.

[SEAL.] JOHN A. SHIELDS, *Clerk.*

United States Circuit Court, Southern District of New York. At Law.

EMIL WERCKMEISTER, QUI TAM,
vs.
AMERICAN TOBACCO COMPANY.

Motion for a New Trial.

Wheeler, *J.:*

Sec. 4965 of the Rev. Stat. U. S. provides that if any person shall infringe a copyright in any of the ways specified:

"He shall forfeit to the proprietor all the plates on which the same shall be copied, and every sheet thereof, either copied
76 or printed, and shall further forfeit one dollar for every sheet of the same found in his possession, either printing, printed, copied, published, imported or exposed for sale; and in case of a painting, statue, or statuary, he shall forfeit ten dollars for every copy of the same in his possession, or by him sold or exposed for sale; one-half thereof to the proprietor and the other half to the use of the United States."

The plaintiff, as proprietor of a copyrighted picture called "The Chorus," brought replevin to recover 1,196 sheets of the same as forfeited to him by the defendant, in which the Marshal returned that he found the same in the possession of the defendant, and in which it was:

"Adjudged that the plaintiff have and retain, is entitled to the possession of 1,196 sheets, each containing a copy of the plaintiff's copyrighted picture, "Chorus," found in the possession of the defendant, and replevied by the United States Marshal, as alleged in plaintiff's complaint."

This suit is brought to recover ten dollars as forfeited for each of

these copies, as found in the possession of the defendant, and upon the trial the plaintiff offered no evidence of the finding of any copies of the picture in the possession of the defendant, but the record in the former case, whereupon a verdict for the defendant was directed, and this motion was made.

The plaintiff relies upon the recital in the former judgment as a conclusive adjudication that the sheets were found in the possession of the defendant. As to this, it is to be noticed that there are, or may be thought to be, two distinct forfeitures imposed by this statute; one of the sheets wherever found to the proprietor,
77 and the other of $10 to him and the United States for each sheet found in the possession of the defendant. In the former suit, the material question would be as to whether there was infringement which would work a forfeiture of the title to the sheets, and the decision upon that may be so far conclusive; the question of finding in possession of the defendant was not material, but only incidental, and a finding upon that would not seem to be conclusive. It was not within the issue joined in the case in which the parties would be bound to bring their proofs, or afterwards remain silent concerning them, but was merely descriptive of the things forfeited and independent of that issue, and the finding upon it would not be material nor conclusive. If this pecuniary forfeiture is only a part of the same forfeiture as that of the sheets, there could, on familiar principles, be but one recovery upon the one forfeiture, and there having been one recovery of the sheets, the right of recovery would be satisfied, and there could not be another of the money. The decided cases do not seem to be in harmony about this, but, whichever are right, it seems clear that if there is but one forfeiture there has been one recovery, which is all there can be, and if there are two, there are two different issues to be tried on evidence of facts, constituting each forfeiture in each action respectively. And if there are two forfeitures there must be two actions, for the rights are different, one belonging to the proprietor alone, and the other to him and the United States. A judgment for the proprietor would not conclude the United States, and consequently not the defendant, for both parties must be concluded by an estoppel or neither is.

This was the view taken at the trial, on which a verdict
78 was directed for the defendant, and the learned argument for the plaintiff on this motion has not changed it.

Motion denied; and judgment on verdict.

ANTONIO KNAUTH,
For Plaintiff.
WILLIAM A. JENNER,
For Defendant.

(Endorsed:)—Circuit Court of the United States for the Southern District of New York.—Emil Werckmeister *vs.* American Tobacco Company.—Opinion, Wheeler, *J.*—U. S. Circuit Court, Southern District of New York.—Filed March 23, 1905.—John A. Shields, Clerk.

(Endorsed:)—United States Circuit Court, Southern District of New York.—Emil Werckmeister *vs.* American Tobacco Co.—Bill of Exceptions.—Briesen & Knauth, Attorneys for Plaintiff, 49 Wall Street, Borough of Manhattan, New York.—U. S. Circuit Court, Southern District of New York.—Filed Jun. 19, 1905.—John A. Shields, Clerk.

Circuit Court of the United States, Southern District of New York.

No. 2.

EMIL WERCKMEISTER, Suing for Himself and the United States, Plaintiff,
against
AMERICAN TOBACCO COMPANY, Defendant.

Assignment of Errors.

And now comes the plaintiff and says that the judgment
79 entered in this action on the 29th day of March, 1905, in the office of the Clerk of the United States Circuit Court for the Southern District of New York, is manifestly erroneous and against the just rights of the plaintiff, for the following reasons namely:

First. The Court erred in holding that in the previous action between said plaintiff and said defendant, in replevin, the judgment record of which was offered in evidence by the plaintiff, the question of finding the infringing pictures in the possession of the defendant was not material, but only incidental.

Second. The Court erred in holding that in said previous action in replevin, the question of finding the infringing pictures in the possession of the defendant was not within the issues joined in the replevin action.

Third. The Court erred in holding that the previous judgment in said replevin action was not conclusive as to the finding in the possession of the defendant of the infringing sheets in question.

Fourth. The Court erred in holding that the previous judgment, pleadings and record of said replevin action, between said parties, was not conclusive evidence as proving the issues in this action on behalf of the plaintiff.

Fifth. The Court erred in holding that a judgment in favor of the proprietor of the copyright in the action to forfeit the articles themselves would not conclude the United States, and consequently not the defendant.

Sixth. The Court erred in holding that the plaintiff in this
80 action was bound to prove the issues therein by evidence other than the judgment and record of the previous action in replevin between the same parties.

Seventh. The Court erred in excluding as immaterial the record of the two replevin proceedings in the previous action in replevin, consisting of affidavits, undertakings, writs of replevin, exhibits and

returns of the Marshals of this Court, all on file in the Clerk's Office of this Court.

Eighth. The Court erred in directing the Jury to render a verdict for the defendant.

Ninth. The Court erred in denying plaintiff's motion to direct a verdict for plaintiff.

Tenth. The Court erred in denying plaintiff's motion to set aside the verdict and for a new trial.

EMIL WERCKMEISTER,
By BRIESEN & KNAUTH,
His Attorneys.

ANTONIO KNAUTH,
Of Counsel.

(Endorsed:)—United States Circuit Court, Southern District of New York.—Emil Werckmeister *vs.* American Tobacco Co.—Assignment of Errors.—Briesen & Knauth, Solicitors for Plaintiff in Error, 49 Wall Street, New York.—U. S. Circuit Court, Southern District of New York.—Filed May 25, 1905.—John A. Shields, Clerk.

81 National Surety Company.

Circuit Court of the United States of America for the Southern District of New York, in the Second Circuit.

EMIL WERCKMEISTER, Plaintiff-Appellant,
vs.
AMERICAN TOBACCO COMPANY, Defendant & Respondent.

Bonds for Damages and Costs.

Know all men by these presents, that the National Surety Company, having an office and principal place of business at No. 346 Broadway, in the City of New York, County and State of New York, is held and firmly bound unto the above-named defendant, American Tobacco Company, in the sum of two hundred and fifty ($250.00) dollars, to be paid to the said American Tobacco Company for the payment of which well and truly to be made, it binds itself, its successors and assigns, jointly and severally, firmly by these presents.

Sealed with its seal and dated the 2d day of May, in the year of our Lord one thousand nine hundred and five.

Whereas, the above-named Emil Werckmeister has prosecuted a writ of error to the United States Circuit Court of Appeals for the Second Circuit, to reverse the judgment rendered in the above
82 entitled action by the Circuit Court of the United States for the Southern District of New York, on the 29th day of March, 1905.

Now, therefore, the condition of this obligation is such that if the above-named Emil Werckmeister shall prosecute said writ of error to effect and answer all damages and costs if he fail to make his plea

good, then this obligation shall be void, otherwise the same shall be and remain in full force and virtue.

Sealed and delivered and taken and acknowledged, this 2d day of May, 1905, before me,

[SEAL.]

BELLE F. JAIS,
Notary Public (47), *County of New York.*

Certificate filed in Kings, Westchester, Richmond and Queens Counties.

[SEAL.]

NATIONAL SURETY COMPANY,
By JOEL RATHBONE,
Res. Vice-President.

Attest:
RICHARD J. MORIARTY,
Res. Assistant Secretary.

Copy of By-Law.

Be it remembered, That at a regular meeting of the Board of Directors of the National Surety Company, duly called and held on the 20th day of May, 1897, a quorum being present, the following by-law was adopted:

"ARTICLE XIII. SEC. 1.—All bonds, recognizances, contracts of indemnity and other writings obligatory in the nature thereof, shall be signed by the President, the Vice-President, the Second Vice-President, a Resident Vice-President, or an attorney in fact, and, except when signed by an attorney in fact, shall have the seal
83 of the Company affixed thereto, duly attested by the Secretary, Assistant Secretary or a Resident Assistant Secretary. The Vice-President, Second Vice-President and Resident Vice-Presidents shall each have authority to sign such instruments whether the President be absent or incapacitated or not; and the Assistant Secretary and Resident Assistant Secretaries shall each have authority to seal and attest such instruments, whether the Secretary be absent or incapacitated or not. All such instruments executed as herein provided shall be as binding upon the Company as if the same were signed by the President, duly sealed and attested by the Secretary."

CITY AND COUNTY OF NEW YORK, *ss:*

I, Richard J. Moriarty, Res. Asst. Secretary of the National Surety Company, have compared the foregoing By-Law with the original thereof, as recorded in the Minute Book of said Company, and do certify that the same is a correct and true transcript therefrom, and of the whole of said original By-Law.

Given under my hand and the seal of the Company, at the City of New York, this 2d day of May, 1905.

RICHARD J. MORIARTY,
Res. Ass't Secretary.

[SEAL.]

CITY AND COUNTY OF NEW YORK, *ss:*

On this 2d day of May, 1905, before me personally appeared Joel Rathbone, Res. Vice-President of the National Surety Company, with whom I am personally acquainted, who, being by me duly sworn, said that he resided in the City of New York; that he is the Res. Vice-President of the National Surety Company; that he knows the corporate seal of said company; that the seal affixed to
84 the within instrument is such corporate seal; that it was affixed by order of the Board of Directors of said Company, and that he signed said instrument as Res. Vice-President of said Company by like authority; and that the liabilities of said Company do not exceed its assets, as ascertained in the manner provided in Section 3, Chapter 720, of New York Session Laws of 1893. And the said Joel Rathbone further said that he is acquainted with Richard J. Moriarty, and knows him to be the Res. Ass't Secretary of said Company; that the signature of the said Richard J. Moriarty, subscribed to the said instrument, is in the genuine handwriting of the said Richard J. Moriarty, and was thereto subscribed by the like order of the said Board of Directors, and in the presence of him, the said Joel Rathbone, Res. Vice-President.

BELLE F. JAIS,
[SEAL.] *Notary Public (No. 47) for the County of N. Y.*

Certificate filed in Kings, Westchester, Richmond and Queens Counties.

(Endorsed:) U. S. Circuit Court. Emil Werckmeister, Plaintiff and Appellant, *vs.* American Tobacco Company, Defendant and Respondent.—Bond for Damages and Costs.—Surety: National Surety Company.—Approved as to form and also as to sufficiency of surety, with reservation, however, to the defendant of the right at any time to examine the proper officers of the Surety Company, under oath, touching its assets, liabilities and financial condition generally.—E. H. Lacombe, U. S. Circuit Judge.—U. S. Circuit Court, Southern District of New York.—Filed May 25, 1905.—John A. Shields, Clerk.

85 By the Honorable E. Henry Lacombe, One of the Judges of the Circuit Court of the United States for the Southern District of New York, in the Second Circuit, to American Tobacco Company, Greeting:

You are hereby cited and admonished to be and appear before a United States Circuit Court of Appeals for the Second Circuit, to be holden at the Borough of Manhattan, in the City of New York, in the District and Circuit above named, on the 23d day of June, 1905, pursuant to a Writ of Error, filed in the Clerk's Office of the Circuit Court of the United States for the Southern District of New York, wherein Emil Werckmeister, suing for himself and the United States, is Plaintiff in Error, and you are Defendant in Error, to show cause, if any there be, why the judgment in said Writ of Error men-

tioned should not be corrected and speedy justice not be done in that behalf.

Given under my hand at the Borough of Manhattan, in the City of New York, in the District and Circuit above named, this 25th day of May, in the year of our Lord One Thousand Nine Hundred and Five, and of the Independence of these United States the One Hundred and Twenty-nine.

E. H. LACOMBE,

[SEAL.] *Judge of the Circuit Court of the United States for the Southern District of New York, in the Second Circuit.*

86 United States Circuit Court of Appeals for the Second Circuit.

No. 135, October Term, 1905.

Argued March 1, 1906; Decided April 4, 1906.

EMIL WERCKMEISTER, Suing for Himself and The United States, Plaintiff in Error,

vs.

THE AMERICAN TOBACCO COMPANY, Defendant in Error.

Error to the Circuit Court of the United States for the Southern District of New York.

Before Judges Wallace, Lacombe and Coxe.

The judgment of the Circuit Court, Southern District of New York, is affirmed.

Antonio Knauth, for the Plaintiff in Error.

William A. Jenner, for the Defendant in Error.

87 United States Circuit Court of Appeals for the Second Circuit.

No. 2.

EMIL WERCKMEISTER, Plaintiff in Error,

vs.

AMERICAN TOBACCO COMPANY, Defendant in Error.

SIRS: Please take notice that on Monday April 16th, 1906, at 10/30 A. M. or as soon thereafter as counsel can be heard, we shall present a proposed order for a mandate to this Court in the above entitled suit, a copy of which proposed order is herewith served upon you for settlement. Dated New York, April 13th, 1906.

Yours, etc.,

WM. A. JENNER,

Of Counsel for Defendant in Error.

To Antonio Knauth, Esq., of Counsel for Plaintiff in Error.

88 At a Stated Term of the United States Circuit Court of Appeals, in and for the Second Circuit, held at the Court Rooms in the Post Office Building in the City of New York, on the 16th day of April one thousand nine hundred and six.

Present: Hon. William J. Wallace, Hon. E. Henry Lacombe, Hon. Alfred C. Coxe, Circuit Judges.

No. 2.

EMIL WERCKMEISTER, Plaintiff in Error,
vs.
AMERICAN TOBACCO COMPANY, Defendant in Error.

An appeal having been taken by the plaintiff in error herein from a judgment of the Circuit Court of the United States for the Southern District of New York.

This cause came on to be heard on the transcript of record from the Circuit Court of the United States, for the Southern District of New York, and was argued by counsel.

On consideration whereof, it is now hereby ordered, adjudged and decreed that the judgment of said Circuit Court be and it hereby is affirmed with costs.

It is further ordered that a Mandate issue to the said Circuit Court in accordance with this decree.

E. H. L.
A. C. C.

89 Endorsed: U. S. Circuit Court of Appeals, for the Second Circuit. Emil Werckmeister Pl't'ff in Error *vs.* American Tobacco Company, Def't in Error. Original Order for Mandate and Notice of Settlement. Wetmore & Jenner, Sol'rs for Def't in Error, 34 Pine St., New York. Service of within order and notice this 13th day of April 1906 is hereby admitted. Antonio Knauth, Counsel for Pl't'ff in Error. United States Circuit Court of Appeals, Second Circuit. Filed Apr. 16, 1906. William Parkin, Clerk.

90 United States Circuit Court of Appeals for the Second Circuit.

EMIL WERCKMEISTER, Plaintiff in Error,
against
AMERICAN TOBACCO COMPANY, Defendant in Error.

Petition for Writ of Error and Supersedeas.

Emil Werckmeister, plaintiff in error in the above-entitled cause, feeling himself aggrieved by the order of this Court entered on the 16th day of April, 1906, comes now, by Briesen & Knauth, his solicitors, and petitions said Court for an order allowing said plaintiff in error to prosecute a writ of error to the Honorable the Supreme Court

of the United States, under and according to the laws of the United States in that behalf made and provided, and also that an order be made fixing the amount of security which the plaintiff in error shall give and furnish upon the said writ of error, and that upon the giving of such security all further proceedings in this Court be suspended and stayed until the determination of said writ of error by the United States Supreme Court.

And your petitioner will ever pray.

EMIL WERCKMEISTER,
By ANTONIO KNAUTH, *Counsel.*

91 At a Stated Term of the United States Circuit Court of Appeals in and for the Second Circuit, held at the Court Rooms thereof, in the Post Office Building, Borough of Manhattan, city of New York, on the 19th day of April, 1906.

Present: Hon. E. Henry Lacombe, Judge.

EMIL WERCKMEISTER, Plaintiff in Error,
against
AMERICAN TOBACCO COMPANY, Defendant in Error.

Upon motion of Briesen & Knauth, solicitors for the plaintiff in error, and upon filing a petition for writ of error and an assignment of errors, it is

Ordered, That a writ of error be and hereby is allowed, to have reviewed in the United States Supreme Court the judgment heretofore entered in the U. S. Circuit Court of Appeals, on the 16th day of April, 1906, and that the amount of the bond on said writ of error be and hereby is fixed at Five Hundred Dollars, and that upon filing said bond all proceedings in that court be suspended and stayed until the determination of said writ by the United States Supreme Court and the entry and service of an order thereon.

E. HENRY LACOMBE, *U. S. C. J.*

92 (Endorsed:) United States Circuit Court of Appeals for the 2nd Circuit. Emil Werckmeister Plaintiff in Error vs. American Tobacco Co. Defendant in Error Copy Petition. Order for Writ of Error. Briesen & Knauth, solicitors for Pl'ff in Error 49 Wall Street, Borough of Manhattan, New York. United States Circuit Court of Appeals, Second Circuit Filed Apr. 19, 1906, William Parkin, Clerk .

93 United States Circuit Court of Appeals for the Second Circuit.

EMIL WERCKMEISTER, Plaintiff in Error,
against
THE AMERICAN TOBACCO COMPANY, Defendant in Error.

Know all men by these presents, That we, Emil Werckmeister, as principal, and the National Surety Company, a corporation organized under the laws of the State of New York, and having an office and

place of business at No. 62 Liberty Street, Borough of Manhattan, City of New York, as surety are held and firmly bound unto the above-named defendant, The American Tobacco Company, in the sum of Five Hundred ($500.) Dollars, to be paid to the said The American Tobacco Company, its successors or assigns, for the payment of which well and truly to be made, we bind ourselves and each of us, our and each of our executors, administrators and successors, jointly and severally, firmly by these presents.

Sealed with our seals, and dated the 19th day of April, 1906.

Whereas the above-named Emil Werckmeister has prosecuted a writ of error to the Supreme Court of the United States, to reverse the judgment of affirmance rendered in the above-entitled
94 action in the United States Circuit Court of Appeals in and for the Second Circuit.

Now, therefore, the condition of this obligation is such that if the above bounden Emil Werckmeister shall prosecute the said writ of error to effect and answer all damages and costs if he shall fail to make said plea good then this obligation to be void, otherwise, the same shall be and remain in full force and virtue.

Sealed and delivered this 19th day of April, 1906.

EMIL WERCKMEISTER, [SEAL.]
By R. LESCH, *Att'y in Fact.*
NATIONAL SURETY COMPANY,
By JOEL RATHBONE,
Res. Vice President.

RICHARD J. MORIARTY,
Res. Ass't Secretary.

STATE OF NEW YORK, *County of New York, ss:*

On this 19th day of April, 1906, before me personally came R. Lesch, to me known and known to me to be the individual described in and who executed the foregoing instrument, and known to me to be the attorney in fact of Emil Werckmeister, described in the foregoing instrument, and he duly acknowledged to me that he executed the foregoing instrument as such attorney in fact of Emil Werckmeister.

[SEAL.]

OTTO v. SCHRENK,
Notary Public, N. Y. Co.

95 STATE OF NEW YORK, *County of New York, ss:*

On this 19th day of April, 1906, before me personally appeared Joel Rathbone, Res. Vice President of the National Surety Company, with whom I am personally acquainted, who being by me duly sworn, said that he resides in the County of New York; that he is the Res. Vice President of the National Surety Company, the corporation described in and which executed the within instrument; that he knows the corporate seal of said Company; that the seal affixed to the within instrument is such corporate seal; that it was affixed by order of the Board of Directors of said Company, and that he signed said instrument as Res. Vice President of said Company by like

authority; and that the liabilities of said Company do not exceed its assets, as ascertained in the manner provided by Section 3, Chapter 720 of New York Session Laws of 1893. And the said Joel Rathbone further said that he is acquainted with Richard J. Moriarty, and knows him to be the Res. Asst. Secretary of said Company; that the signature of the said Richard J. Moriarty subscribed to the said instrument is in the genuine handwriting of the said Richard J. Moriarty, and was thereto subscribed by the like order of the said Board of Directors and in the presence of him, the said Joel Rathbone, Res. Vice President.

MOLLIE SCHOENBRUN,
Notary Public for the County of New York, No. 347.

Certificate filed in Kings, Westchester, Richmond & Queens Counties.

Copy of By-Law.

Be it remembered, That at a regular meeting of the Board of Directors of the National Surety Company, duly called and held on the 6th day of February, 1900, a quorum being present, the following By-Law was adopted:

"ARTICLE XIII. Sec. 1.—*Signatures Required.* All bonds, recognizances, contracts of indemnity and other writings obligatory in the nature thereof, shall be signed by the President, the Vice-President, the Second Vice-President, or an attorney in fact, and, except when signed by an attorney in fact, shall have the seal of the Company affixed thereto, duly attested by the Secretary, an Assistant Secretary or a Resident Assistant Secretary. The Vice-President, Second Vice President and Resident Vice-Presidents shall each have authority to sign such instruments whether the President be absent or incapacit-ed or not; and the Assistant Secretary and Resident Assistant Secretaries shall each have authority to seal and attest such instruments whether the Secretary be absent or incapacit-ed or not. All such instruments executed as herein provided shall be as binding upon the Company as if the same were signed by the President, duly sealed and attested by the Secretary."

96 STATE OF NEW YORK, *County of New York, ss:*

I Richard J. Moria-ty, Res. Asst. Secretary of the National Surety Company, have compared the foregoing copy of By-Law with the original thereof, as recorded in the Minute Book of said Company, and do certify that the same is a correct and true transcript therefrom, and of the whole of said original By-Law.

Given under my hand and seal of the Company this 19th day of April, 1906.

[L. S.] RICHARD J. MORIARTY,
Res. Ass't Secretary.

Approved as to form and also as to sufficiency of sureties, with reservation, however, to the defendant in error of the right at any

time to examine the proper officers of the Surety Company, under oath, touching its assets, liabilities, and financial condition generally.

E. HENRY LACOMBE,
U. S. Circuit Judge.

97 (Endorsed:) United States Circuit Court, of Appeals for the 2nd Circuit. Emil Werchmeister Plff. in Error *vs.* American Tobacco Co. Deft. in Error. Copy Bond on Writ of Error. Briesen & Knauth, Solicitors for Plaintiff in Error, 49 Wall Street, Borough of Manhattan, New York. United States Circuit Court of Appeals, Second Circuit. Filed Apr. 19, 1906. William Parkin, Clerk.

98 Supreme Court of the United States.

EMIL WERCKMEISTER, Suing for Himself and the United States,
Plaintiff in Error,
against
AMERICAN TOBACCO COMPANY, Defendant in Error.

Assignment of Errors.

Afterwards, to wit, on the 19th day of April, 1906, before the Justices of the Supreme Court of the United States, at the Capitol in the City of Washington, comes the said Emil Werckmeister, by Briesen & Knauth, his attorneys, and says that by the record proceedings aforesaid there is manifest error in the conclusion, determination and judgment of the Honorable Circuit Court of Appeals for the Second Circuit, made and entered herein on April 16th, 1906, in the following respects, to wit:—

First. Error in not determining that the Trial Court erred in holding that in the previous action between the parties to this action, the judgment record of which was offered in evidence by the plaintiff at the trial, the question of finding the infringing pictures in the possession of the defendant was not material but only incidental.

Second. Error in not determining that the Circuit Court erred in holding that in said previous action between the parties to
99 this action the question of finding the infringing pictures in the possession of the defendant was not one of the issues joined in the previous action.

Third. Error in not determining that the Circuit Court erred in holding that the previous judgment in the action in the nature of a replevin action between the parties was not conclusive as to the finding in the possession of the defendant of the infringing sheets in question.

Fourth. Error in not determining that the Circuit Court erred in holding that the previous judgment pleadings and record of said previous action between the parties was not conclusive evidence as proving the issues in this action.

Fifth. Error in not determining that the Circuit Court erred in

holding that a judgment in favor of the proprietor of the copyright in the action to forfeit the articles themselves would not conclude the United States and consequently not the defendant.

Sixth. Error in not determining that the Circuit Court erred in holding that the plaintiff in this action was bound to prove the issues therein by evidence other than the judgment and record of the previous action in the nature of a replevin between the same parties.

Seventh. Error in not determining that the Circuit Court erred in excluding as immaterial the record of the two proceedings by writs in the nature of replevin in the previous action, consisting
100 of affidavits, undertakings, writs, exhibits and returns of the Marshals of said Circuit Court, all on file in the Clerk's office of said Circuit Court, whereby it appeared that eleven hundred and ninety-nine copies of the copyrighted painting were found by said Marshals in the possession of the defendant previous to the commencement of this action to which ruling the plaintiff duly excepted.

Eighth. Error in not determining that the Circuit Court erred in directing the jury to render a verdict for the defendant, to which ruling the plaintiff duly excepted.

Ninth. Error in not determining that the Circuit Court erred in denying the plaintiff's motion to direct a verdict for the plaintiff for the relief demanded in the complaint, to which ruling the plaintiff duly excepted.

Tenth. Error in not determining that the Circuit Court erred in denying plaintiff's motion to set aside the verdict and for a new trial, to which ruling the plaintiff duly excepted.

EMIL WERCKMEISTER,
By ANTONIO KNAUTH,
His Counsel.

101 (Endorsed:) Supreme Court of the United States. Emil Werckmeister, Plaintiff in Error *vs.* American Tobacco Co. Defendant in Error. Copy Assignment of Errors. Briesen & Knauth, Solicitors for Plaintiff in Error, 49 Wall Street, Borough of Manhattan, New York. United States Circuit Court of Appeals, Second Circuit. Filed Apr. 19, 1906. William Parkin, Clerk.

102 UNITED STATES OF AMERICA,
Southern District of New York, ss:

I William Parkin, Clerk of the United States Circuit Court of Appeals for the Second Circuit, do hereby Certify that the foregoing pages, numbered from 1 to 101 inclusive, contain a true and complete transcript of the record and proceedings had in said Court, in the case of Emil Werckmeister, Pl't'f in Error, against American Tobacco Co., Def't in Error, as the same remain of record and on file in my office.

In testimony whereof, I have caused the seal of the said Court to be hereunto affixed, at the City of New York, in the Southern District of New York, in the Second Circuit, this 26th day of April, in

the year of our Lord One Thousand Nine Hundred and Six and of the Independence of the said United States the One Hundred and Thirtieth.

[Seal United States Circuit Court of Appeals, Second Circuit.]

WM. PARKIN, *Clerk.*

103 By the Honorable E. Henry Lacombe, one of the Judges of the United States Circuit Court of Appeals for the Second Circuit, to American Tobacco Company, Greeting:

You are hereby cited and admonished to be and appear before a United States Supreme Court to be holden at the Capitol in the City of Washington, on the 15" day of May, 1906, pursuant to a writ of error filed in the Clerk's office of the United States Circuit Court of Appeals for the Second Circuit, wherein Emil Werckmeister is plaintiff in error and you are defendant in error, to show cause, if any there be, why the judgment is said writ of error mentioned should not be corrected and speedy justice should not be done in that behalf.

Given under my hand at the Borough of Manhattan, in the City of New York, in the District and Circuit above named, this 19" day of April, in the year of our Lord one thousand nine hundred and six, and *in* the Independence of these United States the one hundred and thirtieth.

E. HENRY LACOMBE,
Judge of the Circuit Court of Appeals of the United States for the Second Circuit.

104 [Endorsed:] 2421. United States Circuit Court of Appeals for the 2nd Circuit. Emil Werckmeister, Plaintiff in Error, *vs.* American Tobacco Co., Defendant in Error. Citation. Briesen & Knauth, Solicitors for Plaintiff in Error, 49 Wall Street, Borough of Manhattan, New York. Service of a copy of the within citation is hereby admitted this 19th day of April, 1906. Wetmore & Jenner, Solicitors for Def't in Error. United States Circuit Court of Appeals, Second Circuit. Filed Apr. 20, 1906. William Parkin, Clerk.

105 UNITED STATES OF AMERICA, *ss:*

The President of the United States of America to the Judges of the United States Circuit Court of Appeals for the Second Circuit, Greeting:

Because in the record and proceedings, as also in the rendition of the judgment of a plea which is in the said United States Circuit Court of Appeals before you, or some of you, between Emil Werckmeister, plaintiff in error, and American Tobacco Company, defendant in error, a manifest error hath happened, to the great damage of the said Emil Werckmeister, as is said and appears by his complaint: we being willing that such error, if any hath been, should be duly corrected and full and speedy justice done to the parties

aforesaid in this behalf, do command you, if judgment be therein given, that then, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Justices of the Supreme Court of the United States, at the Capitol in the City of Washington, together with this writ, so that you have the same at the said place before the Justices aforesaid on the 15 day of May, 1906, that the record and proceedings aforesaid being inspected, the said Justices of the Supreme Court may cause further to be done therein to correct that error, what of right and according to law and custom of the United States ought to be done.

Witness, the Honorable Melville W. Fuller, Chief Justice of the Supreme Court of the United States, this 19th day of April,
106 in the year of our Lord one thousand nine hundred and six, and of the Independence of the United States of America the one hundred and thirtieth.

[Seal United States Circuit Court of Appeals, Second Circuit.]

WM. PARKIN,
Clerk of the Circuit Court of Appeals of the United States of America for the Second Circuit.

The foregoing writ is hereby allowed.

E. HENRY LACOMBE,
U. S. Circuit Judge.

107 [Endorsed:] 2421. Supreme Court of the United States. Emil Werckmeister, Plaintiff in Error, *vs.* American Tobacco Co., Defendant in Error. Writ of Error. Briesen & Knauth, Solicitors for Pl'ff in Error, 49 Wall Street, Borough of Manhattan, New York. Service of a copy of the within Writ of Error is hereby admitted this 19th day of April, 1906. Wetmore & Jenner, Solcts. for Def't in Error. United States Circuit Court of Appeals, Second Circuit. Filed Apr. 20, 1906. William Parkin, Clerk.

Endorsed on cover: File No. 20,247. U. S. circuit court of appeals, 2d circuit. Term No. 288. Emil Werckmeister, plaintiff in error, *vs.* American Tobacco Company. Filed May 5th, 1906. File No. 20,247.

In the Supreme Court of the United States.

OCTOBER TERM, 1906.

No. 287.

AMERICAN TOBACCO COMPANY,
Plaintiff in Error,
vs.
EMIL WERCKMEISTER,
Defendant in Error.

OCTOBER TERM, 1906.

No. 288.

EMIL WERCKMEISTER, suing for himself and the United States,
Plaintiff in Error,
vs.
AMERICAN TOBACCO COMPANY,
Defendant in Error.

Now comes the defendant in error in Cause No. 287 and plaintiff in error in Cause No. 288, by Antonio Knauth, his counsel, appearing in that behalf, and moves the Court to advance the argument and

hearing of these two cases on the calendar of this Court for the reasons stated in the accompanying statement.

ANTONIO KNAUTH,
Counsel for Emil Werckmeister, Defendant in Error in Cause No. 287 and Plaintiff in Error in Cause No. 288.

I hereby join in the foregoing motion to advance causes Nos. 287 and 288 on the calendar of this Court.

WILLIAM A. JENNER,
Counsel for American Tobacco Co., Plaintiff in Error in Cause No. 287 and Defendant in Error in Cause No. 288.

IN THE SUPREME COURT OF THE UNITED STATES,

OCTOBER TERM, 1906.

No. 287.

AMERICAN TOBACCO COMPANY,
Plaintiff in Error,
vs.
EMIL WERCKMEISTER,
Defendant in Error.

OCTOBER TERM, 1906.

No. 288.

EMIL WERCKMEISTER, suing for himself and the United States,
Plaintiff in Error,
vs.
AMERICAN TOBACCO COMPANY,
Defendant in Error.

Statement.

An early hearing and determination of these two causes in advance of their order on the calendar of this Court is respectfully urged for the following reasons:

It now seems very doubtful whether these two causes will be reached for argument at the present term of this Court. These two actions were brought by Emil Werckmeister to enforce penalties under the Copyright Statute, Section 4965 of the Revised Statutes, the first, No. 287, being an action in the

nature of an action of replevin to recover certain sheets infringing the copyright, and the second cause, No. 288, being brought to recover the money penalties upon the number of infringing sheets found and seized in the first action. These cases involve some questions not heretofore decided by this Court and upon which there is a diversity of opinion between the Circuit Court of Appeals for the Second Circuit and that of the First Circuit, on one branch of the cases, and another diversity of opinion between the Circuit Court of Appeals for the Second Circuit and that for the Third Circuit, upon another branch of these cases. The questions are of general importance to all owners of copyrights and the present uncertainty about their proper decision and the proper interpretation of the Copyright Statute has been one of the reasons why a new proposed copyright statute failed at the last session of Congress, there being much diversity of opinion thereon in the committees who had charge of the proposed copyright bill. The work of these committees is to be taken up again during the coming summer season with a view to present the bill again to the next Congress in the fall of this year. A decision of this Court upon these important points is awaited by all those interested in the new proposed copyright legislation with great interest.

More particularly the questions on which the Circuit Courts of Appeals for the Second and for the First Circuits, respectively, are not in harmony, are, whether the original picture painted by an artist must be marked with a copyright notice under the statute and also whether the exhibition of such picture at a public gallery amounts to a publication of the picture within the meaning of the Copyright Statute. The principal decisions, conflicting on this point are:

Werckmeister vs. *Amer. Lithographic Co.*, 134 F. R., 321, and

Pierce & Bushnell Mfg. Co. vs. *Werckmeister*, 72 F. R., 54.

On the question as to the proper mode of proceeding under this penalty statute there is a sharp conflict between the decisions of the Circuit Court of Appeals for the Third Circuit, where it is held that two actions must be brought successively, one for the recovery of the infringing sheets, and another, thereafter, for the recovery of the money penalty, *Falk* vs. *Curtis Pub. Co.*, 98 F. R., 989; Same *vs.* Same, 100 F. R., 77; Same *vs.* Same, 102 F. R., 967; Same *vs.* Same, 107 F. R., 126, while in the present case the courts in the Second Circuit have held that one action for the recovery of both penalties is proper, following:

Hegeman vs. *Springer*, 110 F. R., 374; and

Springer Lith. Co. vs. *Falk*, 59 F. R., 707.

In consequence of this ruling the Circuit Court dismissed Werckmeister's second action for the recovery of the money penalty.

In deciding these cases the Circuit Court of Appeals said:

> "*There have been a great number of decisions upon this vexed question as to how the relief accorded by Section 4965 (U. S. Comp. St., 1901, p. 3414) shall be secured, and they are not altogether harmonious. It will not be profitable to discuss them. The question can be decided only by the Supreme Court, and even if we were of the opinion that the action and the writ were of more doubtful validity than we are inclined to attribute to them, it would seem to be the wiser course to affirm, and thus secure a final determination of the question, since upon all the other propositions in the case we are satisfied that no error was committed by the trial Court.*"
>
> *Amer. Tobacco Co.* vs. *Werckmeister*, *146 F. R. 375.*

This was the decision in Cause No. 287, while in Cause No. 288 the Court simply affirmed the judg-

ment of the Circuit Court, without rendering any opinion.

Werckmeister vs. *Amer. Tobacco Co.*, *144 F. R., p. 1023.*

The unsatisfactory condition of the present interpretation of the statute is very clearly shown by reading the decision of the Circuit Court (Wheeler, *J.*) which was thus affirmed by the Circuit Court of Appeals (*Werckmeister* vs. *American Tobacco Co.*, *138 F. R., 162*).

In this condition of the decisions it is practically impossible to advise owners of copyrights as to how they shall proceed to recover the statutory penalties, and this part of the copyright statute is thus made nugatory.

The briefs on behalf of Emil Werckmeister in both cases have been printed and filed, the briefs on behalf of the American Tobacco Co. will be ready and on file by April 15, and an early disposition of these cases is desired by both sides to these litigations.

Respectfully submitted,

ANTONIO KNAUTH,
Counsel for Emil Werckmeister, defendant in error in Cause No. 287 and for plaintiff in error in Cause No. 288.

[redacted]

29.

Supreme Court of the United States.

[redacted]

ERNST WERTHEIMSTER,
KING FOR PROFIT AND THE UNITED STATES,
Plaintiff in Error
(Plaintiff below),

vs.

AMERICAN TOBACCO COMPANY,
Defendant in Error
(Defendant below).

BRIEF FOR PLAINTIFF IN ERROR.

ANTONIO KNAUTH,
Of Counsel for Plaintiff in Error.

PRESS OF BYRNE PRINTING OFFICE, NEW YORK.

Supreme Court of the United States.

No. 288.

EMIL WERCKMEISTER, suing for himself and the United States,
Plaintiff in Error
(Plaintiff below),

vs.

THE AMERICAN TOBACCO COMPANY,
Defendant in Error
(Defendant below).

BRIEF FOR PLAINTIFF IN ERROR.

This is a writ of error to review a judgment of the United States Circuit Court of Appeals for the Second Circuit affirming a judgment of the United States Circuit Court for the Southern District of New York, entered in the Circuit Court on March 29, 1905, dismissing the plaintiff's complaint upon the merits, with costs, a verdict having been rendered by direction of the Court in favor of the defendant at the close of the trial (R., p. 47; also p. 9).

The action was a *qui tam* action, brought to recover the money penalties for infringement of copyright, provided by Section 4965 of the Revised Statutes, relating to copyrights, the plaintiff de-

manding judgment for himself and the United States of America against the defendant for the sum of ten thousand dollars ($10,000), one half thereof to be paid to him and the other half to the United States, together with the costs of the action. No evidence was offered by the defendant at the trial of the case and the questions presented all go to the admissibility and sufficiency of the evidence presented by the plaintiff at the trial and to the question, whether the action could be maintained at all in view of the previous action for the condemnation of the infringing sheets, in which the plaintiff had been successful and which is on appeal before this Court as No. 287.

The actions resorted to by the plaintiff in order to obtain the relief by way of forfeiture of the infringing sheets and the money penalties provided by Section 4965 consisted in an action in the nature of an action of replevin in which infringing sheets were found in the possession of defendant, American Tobacco Company, by writs issued to the Marshal at the commencement of that action; and by thereafter instituting the present action for the recovery of the money penalties upon the number of sheets so found by the Marshal and subsequently condemned, after a trial of the first action. The questions at issue under the pleadings in the two actions were the same as to every material point and the plaintiff confined himself at the trial of the present action to proving the judgment roll in the previous action, which, for the sake of convenience, we will hereafter shortly term the "replevin action," and also the writs and documents upon which the same were issued, together with the returns of the Marshals endorsed thereon showing the finding of the required number of infringing sheets in the possession of the defendant. The present action was commenced by the service of the summons upon the defendant on July 17, 1903 (R., p. 11, fol. 20).

The Pleadings.

The amended complaint of the plaintiff alleged the obtaining of a copyright in the United States by him on the picture "Chorus," under an assignment from the author of the picture, W. Dendy Sadler, and compliance with the requirements of the statute on the part of the plaintiff, all in the same terms as alleged in the previous action. It then alleged in paragraph XI. that on or about June 23, 1902, and previous to the commencement of this action, the plaintiff commenced an action in the same court against the same defendant in the nature of an action of replevin for the purpose of recovering whatever unlawful copies of the copyrighted picture might be found in the possession of the defendant, and that in said action the plaintiff obtained two writs of replevin, which were executed on June 23, 1902, and July 22, 1902, respectively, by the Marshals of the Court, by seizing in the defendant's possession one thousand one hundred and ninety-six (1,196) sheets containing copies prepared in violation of the copyright. An allegation that defendant had caused to be printed and published said copies, was contained in paragraph X.

The complaint claimed the penalty of ten dollars ($10) for every sheet containing a copy of said painting "Chorus" made in violation of said plaintiff's copyright, and found in said defendant's possession, as aforesaid, one-half to go to the plaintiff and one-half to the United States (R., pp. 3 to 5 inc.).

The defendant's answer admitted that in June, 1902, the defendant had certain lithographed pictures which had been made for the defendant by the American Lithographic Co. and which the defendant understood to be claimed by the plaintiff and that certain pictures were seized by the Marshal of this Court and carried away by him, it being claimed that the number of the pictures was one

hundred and thirteen (113). The answer was substantially the same as the defendant's answer in the previous case, No. 287 (R., pp. 6 to 8, inc).

The Trial.

At the trial plaintiff's counsel, after showing the date of commencement of the present action, offered in evidence the entire judgment roll in the previous replevin action, consisting of the summons, pleadings, minutes of trial, bill of costs and final judgment entered in that action, and after explaining that the offer was made under the claim that the judgment in the previous action was *res adjudicata* upon all the matters in issue between the same parties in the present action, the judgment roll was received in evidence and marked Exhibit "B" (R., pp. 11–15). The Court, differing with plaintiff's counsel as to the legal effect of this evidence, the plaintiff was thereafter permitted to and did offer in evidence the two writs of replevin, affidavits and undertakings in the previous action together with the Marshals' returns therein, showing the seizure of two hundred and three (203) copies in New York and nine hundred and ninety-six (996) copies in Buffalo in defendant's possession in June, 1902 (R., pp. 15 to 16).

The judgment entered in the previous action

> "Adjudged that the plaintiff have and retain, and is entitled to the possession of one thousand one hundred and ninety-six (1,196) sheets, each containing a copy of the plaintiff's copyrighted picture 'Chorus' found in the possession of the defendant and replevied by the United States Marshal, all, as alleged in plaintiff's complaint, said sheets having been made in violation of plaintiff's copyright, and that the same are forfeited to the plaintiff and are of the value of one thousand and ten dollars ($1,010); and it is further
>
> Adjudged that the plaintiff recover from

> the defendant the sum of eighty-nine and 30/100 dollars ($89.30), his costs and disbursements as taxed, and that the plaintiff have execution therefor " (Record, p. 39).

These replevin papers in the previous action, together with the returns of the Marshals certifying the finding in defendant's possession of the copies in question, were subsequently excluded by the Court as immaterial, to which exception was taken by the plaintiff (Record, p. 16, fol. 29). The plaintiff asked for a verdict in favor of the plaintiff, which was denied, and the Court directed a verdict in favor of defendant, to which denial and direction exceptions were severally taken by the plaintiff (Record, *Ib.*). A motion was thereupon made by the plaintiff to set aside the verdict as being against the evidence and against the law, which was entertained by the Court and was thereafter submitted to the Court on briefs of both parties; but the motion was subsequently denied by the Court, and an opinion filed by the Honorable Judge who presided at the trial (Wheeler, *J.*), which opinion is found on pages 40–41 of the record (138 Fed. Rep., 162). Judgment for the defendant was thereafter entered on March 29, 1905, whereupon the plaintiff filed his bill of exceptions.

Both forfeiture actions coming up to the United States Circuit Court of Appeals, on writs of error, at the same time, that Court filed an opinion only in the first case reported in Vol. 146, F. R., 375, in which the Court said at p. 376:

> " There have been a great number of decisions upon this vexed question as to how the relief accorded by Section 4965 shall be secured, and they are not altogether harmonious. It will not be profitable to discuss them. The question can be decided only by the Supreme Court," &c.

The judgment in the present case was affirmed without opinion.

The Assignment of Errors.

The plaintiff in error claimed the following errors, which are all insisted on:

FIRST.—Error in not determining that the trial Court erred in holding that in the previous action between the parties to this action, the judgment record of which was offered in evidence by the plaintiff at the trial, the question of finding the infringing pictures in the possession of the defendant was not material but only incidental.

SECOND.—Error in not determining that the Circuit Court erred in holding that in said previous action between the parties to this action the question of finding the infringing pictures in the possession of the defendant was not one of the issues joined in the previous action.

THIRD.—Error in not determining that the Circuit Court erred in holding that the previous judgment in the action in the nature of a replevin action between the parties was not conclusive as to the finding in the possession of the defendant of the infringing sheets in question.

FOURTH.—Error in not determining that the Circuit Court erred in holding that the previous judgment, pleadings and record of said previous action between the parties was not conclusive evidence as proving the issues in this action.

FIFTH.—Error in not determining that the Circuit Court erred in holding that a judgment in favor of the proprietor of the copyright in the action to forfeit the articles themselves would not conclude the United States and consequently not the defendant.

SIXTH.—Error in not determining that the Circuit Court erred in holding that the plaintiff in this action was bound to prove the issues therein by evidence other than the judgment and record of the previous action in the nature of a replevin between the same parties.

SEVENTH.—Error in not determining that the Circuit Court erred in excluding as immaterial the record of the two proceedings by writs in the nature of replevin in the previous action, consisting of affidavits, undertakings, writs, exhibits and returns of the Marshals of said Circuit Court, all on file in the Clerk's office of said Circuit Court, whereby it appeared that eleven hundred and ninety-nine copies of the copyrighted painting were found by said Marshals in the possession of the defendant previous to the commencement of this action, to which ruling the plaintiff duly excepted.

EIGHTH.—Error in not determining that the Circuit Court erred in directing the jury to render a verdict for the defendant, to which ruling the plaintiff duly excepted.

NINTH.—Error in not determining that the Circuit Court erred in denying the plaintiff's motion to direct a verdict for the plaintiff for the relief demanded in the complaint, to which ruling the plaintiff duly excepted.

TENTH.—Error in not determining that the Circuit Court erred in denying plaintiff's motion to set aside the verdict and for a new trial, to which ruling the plaintiff duly excepted.

POINT I.

The forfeitures provided by the statute are cumulative.

The words used in the statute admit of no other construction than that the two remedies, the recovery of the unlawful sheets and the recovery of the money penalty, are cumulative remedies to which the plaintiff is entitled, and it has been uniformly so held. There is considerable difference of opinion as to whether the two remedies may be claimed in one action of forfeiture, or whether they must be claimed in different actions, but previous to the decision by the Circuit Court in the present case there was no decision by any court that the two remedies *must* be sought in one action. We believe, with the courts in the Third Circuit, that whenever the money penalty is sought to be recovered for sheets which have been found in the defendant's possession, there must be a previous action for the recovery of the sheets and the finding of the sheets therein by means of proper process. This seems to us to be the necessary consequence of what was discussed by this Court in Thornton *vs.* Schreiber.

Thornton v. *Schrieber*, *124 U. S.*, *612*, was a *qui tam* action, brought to recover the penalty of one dollar for each sheet found in the defendant's possession, and the case being decided in February, 1888, the action was maintained under Section 4965 of the Revised Statutes, being the Act of July 8, 1870, Chapter 230, 16 Statutes at Large, 214. This Court, through Mr. Justice Miller, observed that the section gave no right of action to recover damages, merly as such, but limited the remedy to the forfeiture of the plates and every sheet of the photograph in question, either copied or printed; and to the further forfeiture of "one dollar for every sheet of the same found in his possession, either printing,

printed, copied, published, imported or exposed for sale."

In case of a "painting, statue or statuary," there is to be a forfeiture of ten dollars for every copy found in the defendant's possession or by him sold or exposed for sale.

The case was that of a copyrighted photograph. The plaintiff sued as well for the United States as for himself, under the idea that the Government was entitled to one moiety of the penalty recovered, and the learned Justice expressed a doubt as to whether under the reading of the statute, as then in force, the provision for sharing the money penalty with the United States related any further than to the case of paintings, statues or statuary. He was of opinion that the money forfeiture for the copyrighted photograph went to the proprietor of the copyright alone, but did not decide the point. The case turned upon the fact that no infringing sheets had been found in the defendant's possession, and finally the Court said, at p. 620:

> *"Counsel for defendants in error, Schreiber & Sons, insist that the words 'found in his possession' are to be construed as referring to the finding of the jury; that the expression means simply that where the sheets are ascertained by the finding of the jury to have been at any time in the possession of the person who committed the wrongful act, such person shall forfeit one dollar for each sheet so ascertained to have been in his possession. We, however, think that the word 'found' means that there must be a time before the cause of action accrues at which they are found in the possession of the defendants."*

The Court also found that the defendant was only an employee, and therefore never had the legal possession of the sheets in question, and reversed the verdict in favor of the plaintiff.

It will be seen that the words of the Supreme Court, *"that there must be a time before the cause of action accrues at which they are found in the*

possession of the defendant," refer only to the claim of the plaintiff for the money penalty, no claim being made in the action for the forfeiture of the sheets found in defendants' possession by some writ of the Court. As we understand these words, they plainly mean that there must be a previous finding of the sheets in defendant's possession before any cause of action accrues for the recovery of the money penalty. The decision is thus understood by the Courts in the Third Circuit, and the inference seems irresistible that an action for the recovery of the money penalty cannot be commenced until after sheets have been found in the defendant's possession because the action does not accrue until that fact has appeared.

In Bolles *v.* Outing Co., 77 Fed. Rep., 966, 968 (decided in 1897), the United States Circuit Court of Appeals for the Second Circuit held that the provision of the section of the Revised Statutes in question applied only to sheets shown to have been in fact discovered in the defendant's possession prior to the bringing of the suit. The plaintiff sought to recover the money penalties only, and the question in the suit turned entirely upon the fact whether he could recover these penalties upon proving merely that the infringing sheets had been delivered into the possession of the defendant. The Court held that he could not, saying:

> "We are of the opinion that the section means to affix the penalty only when the sheets are shown to have been discovered or detected in the possession of the defendant prior to the bringing of the suit."

So far the language of the opinion is in entire harmony with Thornton *v.* Schreiber, and also with all the cases decided since Backus *v.* Gould, 7 How., 798.

The Court also said:

> "The statute is apparently framed to give the party whose copyright has been invaded

> complete relief by an action in which he can procure a condemnation of the infringing sheets, and at the same time recover by way of compensation a penalty for every sheet which he is entitled to condemn. The words 'found in his possession,' aptly refer to a finding for the purposes of forfeiture and condemnation. The remedy by condemnation and forfeiture is only appropriate in a case where the property can be seized upon process; and where, as here, the forfeiture declared is against property of the 'offender,' it is only appropriate when it can be seized in his hands. The section contemplates two remedies enforceable in a single suit, each of which depends upon the same state of facts. The aggrieved party may, at his election, pursue either one or *both remedies*, but it does not contemplate a recovery of penalties, except in respect to the sheets which can be condemned."

It will be observed that this case was one of a copyrighted photograph, and that the question as to whether any penalty could be recovered for infringing articles *sold* by the defendant, as is specifically prescribed by the statute in the case of paintings, did not arise. The remark that the two remedies might be had in one suit was *obiter*.

When this case, although upon a second appeal, came before this Court, this Court, sustaining the decision of the Circuit Court of Appeals, seemed to approve this *obiter dictum* by saying:

> "No remedy is provided by the act, although by Sec. 4970 a bill in equity will lie for an injunction, but the provision for a forfeiture of the plates and of the copies seems to contemplate an action in the nature of replevin for their seizure, and in addition to the confiscation of the copies, for a recovery of one dollar for every copy so seized or found in the possession of the defendant,"
>
> *Bolles* vs. *Outing Co., 175 U. S., 262, 266.*

There have been some actions in which the courts in the Second Circuit have sustained a recovery of

the seized property together with the money penalty, but the point in question was not raised in those cases. They are:

Hegeman vs. *Springer, 110 Fed. Rep., 874;*
Springer Lithographic Co. vs. *Falk, 59 Fed. Rep., 707.*

The point that two actions were necessary was raised by demurrer in *Falk* vs. *Curtis Publishing Co., 98 Fed. Rep., 989, 991,* before Dallas, *C. J.*, sitting at Circuit in the Eastern District of Pennsylvania (January, 1900), and Judge Dallas sustaining a demurrer to the complaint, said:

> "Hence, it appears that the recovery which he seeks is limited to the penalty of one dollar for every sheet of the alleged infringement found in the defendant's possession, and yet he nowhere alleges that any number of said sheets were so found prior to the bringing of the suit. Therefore, he has failed to allege a fact, the existence of which is necessary to disclose a cause of action (*Bolles* vs. *Outing Co.* (decided by the Supreme Court of the United States, December 4, 1899, not yet officially reported), 20 Supreme Court, 94; Advance Sheets, U. S., 94; 44 L. Ed.) In that case the question arose upon the exclusion of evidence offered upon the trial, and no point was presented respecting the pleading, but, as the Court distinctly held that Section 4965 did not impose a forfeiture of one dollar for any copy or copies which had not been found in the defendant's possession before suit was brought, it necessarily follows that a declaration which omits to allege that any copies were so found is fatally defective. The omission is to allege a fact upon the existence of which the asserted right of recovery is absolutely dependent (citing *Aechtermacht* vs. *Watmough*, 8 Watts and S., 162; *Ferrett* vs. *Atwill*, 1 Blatchf., 151; Fed. Ca., No. 4747)."

In *Falk vs. Curtis Publishing Co.*, 100 Fed. Rep., 77 (Dallas, *C. J.*), the same action came before the Circuit Court, E. D., Penn., in February, 1900, upon demurrer to the amended declaration. The statement of claim alleged that a certain number of sheets had been found in the possession of the defendant previous to the commencement of the action and claimed the penalty of one dollar for every such sheet so found in the possession of the defendant. The declaration was sustained by the Court. The same action came thereafter to trial before the Circuit Court (*102 F. R., 967*), and a verdict was rendered for the plaintiff when the question was reserved for decision whether the penalty had accrued because the suit for the recovery of the money penalty was commenced by the service of a summons at the same time with the execution of a writ of replevin. The Court (McPherson, *D. J.*), upon a review of the authorities, held that the action was prematurely brought because the infringing copies had not been found previous to the institution of the suit. The Court said, after reviewing the cases:

> "Apparently guided by Thornton *vs.* Schreiber, the plaintiff caused two writs to issue at the same time; one beginning an action of replevin to seize the magazines and the other beginning an action of assumpsit to recover the penalties provided by the Act. The writs were put into the Marshal's hands together, and were served simultaneously upon the defendant. The action of replevin has not yet been tried, but in the action of assumpsit a trial has been had and the verdict now being considered has been rendered for the plaintiff. The precise question, therefore, is not whether a single action would lie both for condemnation and for penalty, but whether, since the plaintiff has chosen to bring two suits, the action of assumpsit was not prematurely brought, or, in other words, whether the plaintiff had a cause of action for the penalty at the time the writ in assumpsit was issued. In my opinion, assuming two

> suits to be permissible, he had no such cause of action, and the defendant is therefore entitled to judgment upon the pending motion. In *Thornton* vs. *Schreiber*, *supra*, as already pointed out, the Court declared that 'there must be a time before the cause of action accrued at which (the infringing articles) are found in the possession of the defendant.' The subsequent decisions in *Bolles* vs. *Outing Co.* show that the finding must be by means of a proceeding instituted for the express purpose of condemnation and forfeiture. Taking the decisions together, I think the result would be that no action for the penalty could be brought until the infringing publications have been 'found.' It is this finding that would give the plaintiff a right to sue for the penalty, and obviously he could not begin a suit until he had a cause of action. When, therefore, the present plaintiff issued a writ of assumpsit to recover the penalty denounced by the act, he was suing prematurely * * *. That no cause of action had yet accrued appears clearly, I think, from the further consideration that when the writ of assumpsit was issued, it would have been impossible for the plaintiff to file a statement or declaration. He could not know at that time for how much he was entitled to sue—whether for the penalty upon one copy or for the penalty upon a thousand copies. This could only be determined after the writ of replevin should be executed, and only then, as it seems to me, did the plaintiff have a distinct ascertainable cause of action for the penalty."
>
> *Falk* vs. *Curtis Publ. Co.*, *102 F. R.*, *967*, *971*.

The plaintiff took an appeal to the Circuit Court of Appeals, which sustained the judgment of the Circuit Court, saying:

> "In the case in hand, there was no seizure by condemnation, forfeiture or otherwise before the bringing of the present suit, no prints had been found in the defendant's possession when the summons in assumpsit issued, and consequently the defendant had not then for-

> feited one dollar for every sheet found in his possession. If there was no forfeit when the action began, it follows there was no existing right of action to recover the fruit of the forfeiture; for an action is the prosecution of an existing right. There must be finding before there is forfeiture; there must be forfeiture before the right accrues to sue for the forfeited penalty."
>
> *Falk* vs. *Curtis Pub. Co., 107 Fed. Rep., 126, 128.*

We respectfully submit that by the plain reading of the statute and upon the authority of the decided cases, the plaintiff's course of bringing two actions was proper and the only one which could successfully lead to a complete recovery. There are good additional reasons why this should be so held.

POINT II.

There are intrinsic differences in the actions for the forfeiture of the property and for the payment of the money penalty.

The action for the recovery of the forfeited articles is an action *in rem*. The property in the articles remains in the owner until it is seized, and then by the seizure the title relates back to the time of the forfeiture.

Clark *vs.* Protection Ins. Co., 1 Story (U. S.), 134.

U. S. *vs.* 1,960 Bags of Coffee, 8 Cranch (U. S.), 398.

Gelston *vs.* Hoyt, 3 Wheaton (U. S.), 246, 311.

U. S. *v.* Baker, 5 Ben. (U. S.), 28.

Fontaine *vs.* Phœnix Ins. Co., 11 Johns. (N. Y.), 292.

Amory *vs.* McGregor, 15 Johns., 23.
Henderson's Dist. Spirits, 14 Wall., 44, 56.
Thacher's Distilled Spirits, 103 U. S., 679.
The Mary Celeste, 2 Lowell (U. S.), 356.

> "*There is this strong additional reason in support of the position, that the forfeiture must be deemed to attach at the moment of the commission of the offense, and consequently from that moment the title of the plaintiff would be completely divested, so that he could maintain no action for the subsequent seizure. This is the doctrine of the English courts, and it has been recognized and enforced in this Court upon very solemn argument.*"
>
> *Gelston* vs. *Hoyt*, *3 Wheaton, 246*, on page 311.

In this case the Supreme Court also said, on page 312:

> "*This is a seizure for a forfeiture under the laws of the United States, and consequently the right to decide upon the same, by the very terms of the statute, exclusively belongs to the proper courts of the United States; and it depends upon its final decree, proceeding in rem, whether the seizure is to be adjudged rightful or tortuous. If a sentence of condemnation be pronounced, it is conclusive that a forfeiture is incurred; if a sentence of acquittal, it is equally conclusive against the forfeiture; and in either case the question cannot be litigated in another forum.*"

In *Thacher's Distilled Spirits*, above cited, the Supreme Court said, page 682:

> "Though claimant's counsel sets up the innocence of the present claimant in regard to

> the fraud or any knowledge of it, it can hardly be necessary at this day to reconsider the doctrine that when the act has been done which the law declares to work a forfeiture of the property, the right of the Government to seize the property, and assert the forfeiture, attaches at once and may be pursued by the Government whenever and in whose hands so ever that property may be found."

The action for the recovery of forfeited articles is always regarded as an action *in rem* (*U. S.* vs. *Spring Valley Distillery, 11 Blatchford, 267*). As the action for the recovery of the forfeited articles is an action *in rem*, the Court has jurisdiction over the forfeited articles, whenever they are within the territorial jurisdiction of the Court, and personal service of process upon the defendant in the action is not an essential pre-requisite to the maintenance of the action. The Court would have power to call in the defendant by publication or service of the summons outside of the State.

> *Act of March 3, 1875, Section 8 (18 Stat. at L., 470, 472)*, amending R. S., § 738; also 25 St. at L., 434.
> *Jellenik* vs. *Huron Copper Min. Co., 177 U. S., 1.*
> *Mellen* vs. *Moline, 131 U. S., 352.*

The defendant American Tobacco Company being a New Jersey corporation, this Court had undoubtedly jurisdiction to proceed in the replevin action without personal service, but no jurisdiction to proceed to a decree in the personal action unless the defendant appeared or could be found in this jurisdiction.

> *Scott* vs. *McNeal, 154 U. S., 34, 46.*

On the other hand, the action to be brought for the recovery of the money penalty is a personal ac-

tion, and can be maintained only when the defendant is personally found within the jurisdiction of the Court. The term "forfeit" as applied to a money penalty, means only that the offender shall be made to pay the amount. It means a fine, a mulct.

In re Levy, 30 Chancery Div., 119.
Merchants' Bank *vs.* Bliss, 21 How. Pr. (N. Y.), 370.
Ex parte Alexander, 39 Mo. App., 108.
People *vs.* Nedrow, 122 Illinois, 367.
Commonwealth *vs.* Avery, 14 Bush (Kentucky), 638.
Taylor *vs.* Steamer *Marcella*, 1 Woods (U. S.), 304.

The fiction that the title to forfeited property dates back to the time of the commission of the wrong is applied because convenience and justice requires its application.

Union Transit Refrigerator Co. vs. *Kentucky, 199 U. S., 194, 208.*

It is quite different with the money penalty, which cannot be dated back any further than to the day of finding the sheets in defendant's possession, because that very finding is a condition precedent to the accruing of the money penalty.

As to the sheets, the plaintiff has an inchoate title, which exists as soon as they are wrongfully made, and this inchoate title ripens into a complete title upon condemnation. As to the recovery of the money penalty he can have no such inchoate right; it is a mere claim for payment which arises only after the finding.

POINT III.

It follows from the different nature of the two remedies which are required to enforce the two distinct forfeitures under the statute, that there will be frequently cases where they cannot be combined.

If the property is found in one State, in the hands of an agent or employee, while the offender resides in another State, he could not be sued in the State of his residence, because the property could not be found therein. Neither could he be sued in the State where the property was found, because for the purposes of a personal action the Court will have no jurisdiction over him. If the rule should be established that one suit only can be brought, the plaintiff would lose the money penalty in such a case, if the two remedies must be combined.

POINT IV.

The Circuit Court was plainly in error in holding that the judgment and judgment roll in the previous action did not establish a finding of the infringing sheets in the defendant's possession.

The finding of the sheets by means of writs issued by the Court was alleged in the complaint in the previous action and denied in the answer therein. It constituted an issue, the determination of which was an essential point entitling the plaintiff to the recovery of the sheets in question, because he was entitled to a forfeiture of such sheets only as were found in the defendant's possession in the manner

stated. The issues in the two actions were identical, and every point which was essential for a recovery in the second action was also essential for a recovery in the first action. Indeed, the Circuit Court of Appeals for the Second Circuit, in *Boiles* v. *Outing Company*, 77 F. R., 966, 968, had already held:

> "The section contemplates two remedies enforceable in a single suit, each of which depends upon the same state of facts. The aggrieved party may, at his election, pursue either one or both remedies, but it does not contemplate a recovery of penalties, except in respect to the sheets which can be condemned."

A civil action for the recovery of the money penalty is the proper remedy. The action is one of debt, based on the implied contract to pay, arising from the provisions of the statute. The United States is not a party.

Nishimura Ekiu vs. *U. S.*, *142 U. S.*, *651, 664.*

Walsh vs. *U. S.*, *3 Woodb. & M.*, *341; Fed. Cases No. 17,116.*

Cloud vs. *Hewitt*, *3 Cranch C. C.*, *199.*

Ferrett vs. *Atwill*, *1 Blatchf.*, *151.*

Cole vs. *Smith*, *4 Johnson*, *194.*

Oliphant vs. *Salem F. M.*, *5 Sawyer*, *128.*

U. S. vs. *Griswold*, *30 F. R.*, *762.*

Megargell vs. *Coal Co.*, *8 Watts & S.*, *342.*

Falk vs. *Curtis Publ. Co.*, *98 F. R.*, *989.*

Caswell, qui tam, vs. *Allen*, *10 Johnson*, *118.*

McCoun vs. *N. Y. Central*, *7 Lans.* (*N. Y.*), *75.*

Abbott vs. *N. Y. Central*, *12 Abb. Pr.* (*N. S.*), *465.*

Maryland vs. *Baltimore R. R. Co.*, *3 How.* (*U. S.*), *552.*

POINT V.

The judgment in the replevin action was res adjudicata between the parties upon all the issues in the present case.

A judgment in a former suit is conclusive upon a subsequent one between the same parties or their privies, though upon a different cause of action, if the issues presented in the second suit were involved and fully determined in the first.

New Orleans vs. *Citizens' Bank, 167 U. S., 371, 396;*
Southern Pacific Railroad vs. *U. S., 168 U. S., 1;*
Fayerweather vs. *Ritch, 195 U. S., 276.*

The degree of proof required in the two actions is the same.

Boyd vs. *U. S., 116 U. S., 616;*
The City of Norwich, 118 U. S., 468, 503;
U. S. vs. *Shapleigh, 54 F. R., 126, 131.*

The principle of *res adjudicata* applies to actions for a penalty or forfeiture.

24 Amer. & Eng. Ency. of Law, p. 831, and c. c.;
Commonwealth vs. *Ellis, 160 Mass., 165;*
People vs. *Allen, 1 Parker (Crim., N. Y.), 445;*
State vs. *Intoxicating Liquor, 72 Vt., 253;*
Gelston vs. *Hoyt, 3 Wheaton, 246, 315;*
U. S. vs. *3 Copper Stills, 47 F. R., 495;*
U. S. vs. *Olsen, 57 F. R., 579, 585;*
U. S. vs. *Butler, 38 F. R., 498;*
Commonwealth vs. *Evans, 101 Mass., 26;*
Commonwealth vs. *Feldman, 131 Mass., 588.*

When the facts averred and relied on are substantially the same, the fact that a different form or measure of relief is asked in a subsequent action will not deprive parties of the protection of the prior findings and judgment in their favor.

Greene vs. *Bogue, 158 U. S., 478;*
National Foundry vs. *Oconto Co., 113 F. R., 793.*

As the United States is not a party to the action, the objection that there is no mutual estoppel by the judgment, is not well taken. The plaintiff does not sue in some other capacity, as though he was an executor representing a different person (U. S. *vs.* California L. Co., 192 U. S., 355, 358), but sues in his own right with a liability to pay over half to the United States. That kind of a trusteeship does not prevent the mutual estoppel (*Corcoran* vs. *Chesapeake and Ohio Canal Co., 94 U. S., 741; Freeman on Judgments, § 173*).

Not to give proper effect to the judgment offered in evidence as *res adjudicata* was reversible error.

Dowell vs. *Applegate, 152 U. S., 327.*

POINT VI.

It was also error of the Circuit Court to exclude as immaterial the several writs of replevin issued in the previous action, and the papers upon which they had been issued, together with the returns of the two marshals certifying to the finding of the infringing sheets.

If there was any doubt remaining from the reading of the pleadings in the previous action and the judgment recovered therein, as to the time and place of finding the infringing articles, and the circumstances under which they were found, it was

competent to show by any evidence what had been decided by the judgment in the previous action.

Carson vs. *3 States L. Co., 142 Fed. Rep., 893.*

Harrison vs. *Remington Paper Co., 140 F. R., 385, 400.*

Bredin vs. *Nat'l Metal W. S. Co., 147 F. R., 741.*

POINT VII.

The Circuit Court, upon the evidence presented by plaintiff, should have directed a verdict for the plaintiff for the recovery of the full amount of the penalty provided by the statute, to which the plaintiff was entitled by reason of the proceedings had in the previous action.

POINT VIII.

The judgment of the United States Circuit Court of Appeals, appealed from, and the judgment of the Circuit Court affirmed by it, should be reversed, and a mandate issued, directing the Circuit Court to enter a judgment in favor of the plaintiff as demanded in the complaint.

Respectfully submitted,

ANTONIO KNAUTH,
Of Counsel for Plaintiff in Error.

Office Supreme Court, U. S.
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JAMES H. McKENNEY,
CLERK.

Supreme Court of the United States.

EMIL WERCKMEISTER,
Plaintiff in Error,
(Plaintiff below),
vs.
AMERICAN TOBACCO COMPANY,
Defendant in Error,
(Defendant below).

29.

BRIEF FOR DEFENDANT IN ERROR.

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Supreme Court of the United States.

EMIL WERCKMEISTER,
Plaintiff-in-error,
(Plaintiff below),

vs.

THE AMERICAN TOBACCO COMPANY,
Defendant-in-error,
(Defendant below.)

No. 288.

BRIEF FOR DEFENDANT IN ERROR.

This is a writ of error brought by plaintiff below from a judgment of the Circuit Court of Appeals (First Circuit) affirming a judgment entered upon a verdict of a jury in favor of defendant below, which was directed by the Court upon the close of the plaintiff's evidence.

The action was brought under Revised Statutes, Section 4965 of the Copyright Act, to recover a penalty of $10 for each of 1,196 sheets of the alleged infringement, alleged in the amended complaint to have been found in the defendant's possession and seized by United States Marshals under two writs in a prior action of replevin.

Plaintiff offered only documentary evidence, *to wit*, the summons in the pending action, "for the purpose "of showing that the action was not commenced pre- "vious to the 17th day of July, 1903" (marg., p. 20), and also (marg., p. 20), the judgment roll in the prior action between the same parties "commenced on June 20, 1902" consisting of the summons

(marg., p. 31), the amended complaint (marg. p. 32), the defendant's answer (marg., p. 38), the plaintiff's reply (marg., p. 42), a certified copy of the "minutes of trial" (marg., p. 44), and a certified copy of the judgment (marg., p. 74).

The foregoing papers are comprehended in Plaintiff's Exhibit B (marg., pp. 31 to 44).

The plaintiff thereupon rested his case and defendant moved for the direction of a verdict (marg., p. 26).

After resting, the plaintiff further offered in evidence the returns of the Marshals for the Southern and Western Districts, respectively, showing seizures of 203 copies and 993 copies (marg., p. 28). Defendant objected on the ground that they were incompetent, irrelevant and immaterial. The Court permitted the offer notwithstanding the plaintiff had rested, but excluded the papers as immaterial (marg., p. 29). These papers are printed at marg., pp. 45 to 68.

The Court then ruled on defendant's motion and directed the jury to render a verdict for the defendant (marg., p. 29).

The grounds of defendant's motion to direct a verdict had not been required, either by the Court or by the plaintiff, to be stated, but defendant had objected to receiving in evidence the judgment role in the former action on the following grounds:

(1) That there can be no estoppel in a criminal, penalty or forfeiture case in favor of a prosecutor (Marg., pp. 20 to 22);

(2) That the parties were not the same, the United States being a party to the pending action but not to the former action (Marg., pp. 24–25);

(3) That the same questions were not litigated on the former action as in the pending action (Marg., p. 25);

(4) That the replevin proceedings were illegal (Marg., pp. 25, 26).

The Court directed a verdict for defendant mainly on the point (3) mentioned above referring incidently to the point (2).

After the verdict plaintiff moved to set aside the verdict as against the evidence and against the law. This motion was subsequently heard and was denied, the Court filing an opinion (see Marg., pp. 76–77) in which the Court besides adhering to the earlier reasons, also held, in substance,

(5) That the action for the penalty was barred by the judgment in the replevin action, and that there could not be two separate actions (see Marg., p. 77).

FIRST POINT.

Section 4965 is a highly penal statute and prosecutions under it, although civil in form, are in their substance criminal prosecutions.

It provides for a forfeiture to the proprietor of all plates and sheets, and the further forfeiture of one dollar for every sheet found in possession, with a minimum of not less than $100, and a maximum of not more than $5,000, and, in case of a *painting*, a forfeiture of $10 for every copy in possession or sold or exposed for sale, with a minimum of not less than $250, and a maximum of not more than $10,000.

These pecuniary forfeitures are, in the last sentence of the section, called *penalties*, and one-half of them goes to the proprietor and the other half to the United States.

The amounts of the penalties are arbitrary. They bear no relation to the value of the copyrighted subject, or of the infringement, or to the damage sustained by the proprietor, and whether he sustained any damage is immaterial. No damage need be proved.

Backus vs. Gould, 7 How., 798-811, construing the 6th section of the Act of February 3, 1831 (corresponding to Sec. 4965), in an action to recover penalties thereunder, held the section to be a penal one, and to be construed strictly.

In *Bolles vs. Outing Co.*, 175 U. S., 262-264, where the action was for the penalties under Rev. Stat., § 4965, this Court distinctly held the section to be "clearly a penal statute."

If the section is penal in character, allegations in an action brought under it must be strictly proved and cannot be supported on mere vague surmises.

SECOND POINT.

The judgment roll in the former action was not competent evidence of the matters in issue in this action.

The replevin judgment did not prove the allegations of the complaint.

As the plaintiff offered no evidence to support the allegations of the complaint excepting (1) the summons in this action for the purpose of proving when this action was commenced (Marg., p. 20); (2) the judgment roll in the prior replevin action (Marg., p. 20), and (3) the returns of the United States Marshals showing the number of copies seized (Marg., p. 28), which must be deemed, on this argument, to be a part of the plaintiff's proofs, and as the plaintiff was not debarred from offering any other evidence, it follows that if those documents did not prove the plaintiff's complaint, then the complaint was not proved and the verdict was rightly directed against the plaintiff and must stand.

The plaintiff in error contends (under his Point V.)

that "the judgment in the replevin action was *res adjudicata* between the parties upon all the issues in the present case" and so contended on the trial (Marg., p. 19).

The general rule has never been better stated than in the *Duchess of Kingston's case* (20) Howell's State Trials, 355-538, and 2 Smith's Lead. Cas., 679, 6th Eng. Ed.), as follows:

"The judgment of a court of concurrent jurisdiction, directly upon the point, is, as a plea, a bar, or as evidence conclusive, between the same parties, upon the same matter, directly in question in another court."

Quoted in *Wilson vs. Deen*, 121 U. S., 525, and *Cromwell vs. Sac*, 94 U. S., 351.

The conditions of the application of the rule are:

(1) The *parties* in both actions must have been the *same.*

(2) There must have been a *judgment* in the earlier action.

(3) The former judgment must have been *directly* upon the point which constitutes the matter *directly* in question in the second action.

The party offering the judgment must himself affirmatively prove each and every condition which makes it conclusive as evidence, because, if it is not conclusive, it has no probative force. It does not raise a presumption merely which the opposite party may rebut; it conclusively proves the matter. The party offering the evidence may prove the conditions which make it competent by the papers themselves, if they are of a nature to furnish proof of the conditions, or by extrinsic evidence.

It may be noticed that the judgment in the replevin action was entered upon a verdict "directed" by the Court (m., p. 19), so that if the judgment was an estop-

pel in this action, the defendant will have failed in both without any inquiry by a jury.

As there is not before this Court any proof of the oral testimony on the former trial, the only question is as to the effect of the record as tendered and received in evidence and the Marshals' returns which were offered and excluded, but are now considered as if in the case.

Section 4965, under which this action was brought' is as follows:

"SEC. 4965. If any person, after the recording of the title of any map, chart, dramatic or musical composition, print, cut, engraving, or photograph, or chromo, or of the description of any painting, drawing, statue, statuary, or model or design intended to be perfected and executed as a work of the fine arts, as provided by this act, shall, within the term limited, contrary to the provisions of this act, and without the consent of the proprietor of the copyright first obtained in writing, signed in presence of two or more witnesses, *engrave, etch, work, copy, print, publish*, dramatize, translate, or import, either in whole or in part, or by varying the main design, with intent to evade the law, or, *knowing the same to be so printed, published*, dramatized, translated, or imported, *shall sell or expose to sale any copy of such map or other article*, as aforesaid, *he shall forfeit* to the proprietor all the plates on which the same shall be copied, and every sheet thereof, either copied or printed, and *shall further forfeit* one dollar for every sheet of the same found in his possession, either printing, printed, copied, published, imported, or exposed for sale; and *in case of a painting*, statue, or statuary, *he shall forfeit* ten dollars for every copy of the same in his possession, or by him sold or exposed for sale; Provided, however."

The language more material to this discussion is italicised.

Before the plaintiff could recover the money penalty he was bound to prove that the defendant had either engraved, etched, worked, copied, printed or published the infringement, or that he had sold or exposed to sale the copies *with knowledge* that the same had been so printed, published or imported. The infringing act

must have been in issue and tried in the former case. It must also have been in issue in the pending case, and it must have been determined by the judgment in the former case. That is, the issue in the former action, the issue in the pending action, the proof and the adjudication by the judgment must correspond.

The Complaint in the Present Action.

The material allegation of the complaint in the pending action is in clause Tenth (marg. p. 8), which alleges that the defendant

"did work, copy, print, and publish copies of said copyrighted painting."

Under that allegation it was open for plaintiff to prove that defendant did one or more or all of such acts, and he was bound to prove that defendant did at least one of those acts, and, without such evidence, the plaintiff could not recover $10 for every copy of the painting in defendant's possession or by it sold or exposed for sale.

The only proof offered in support of that allegation was the judgment roll in the former action (Replevin).

The Complaint in the Former Action.

The complaint in the replevin action alleged in clause Ninth (marg. p. 35)

"That * * * said defendant was and still is in possession * * * of 7,338 sheets, each containing a copy of said copyrighted painting *prepared* in violation of plaintiff's copyright wrongfully * * * that said defendant *caused* said copies to be printed for it by the American Lithographic Company and upon delivery thereof to defendant, *published some* of said sheets * * * ."

And then followed allegations of the seizure by the respective Marshals of 203 and 99[illegible] copies. It will be observed that the allegations of the two complaints are not the same.

The gravamen of the penalty action (at bar) is that defendant " did work, copy, print and publish copies." The gravamen of the replevin action was that the defendant " caused said copies " (which were in its possession) " to be printed for it by the American Lithographic Company and upon delivery thereof to defendant, published some of said sheets."

The two complaints tender no material issue in common touching the vital parts of the actions except and unless the allegation that the defendant *published* be the same in both. There is, however, this difference, that the complaint in the case at bar alleges that the defendant " did work, copy, print and publish copies," while the complaint in the replevin action alleged that the defendant " published some " of the sheets which had been delivered to it and which it had caused to be printed by the Lithographic Company.

The Replevin Judgment.

The judgment in the replevin action adjudged as follows (Marg., p. 74) :

" Adjudged that the plaintiff have and retain and " is entitled to the possession of 1,196 sheets, each " containing a copy of the plaintiff's copyrighted " picture Chorus, *found in the possession* of the " defendant, and replevied by the United States " Marshal, all as alleged in the plaintiff's complaint, " said sheets *having been made* in violation of " plaintiff's copyright, and that the same are forfeited " by the plaintiff and are of the value of $1,010."

There was no adjudication that the defendant either worked, copied, printed or *published* either those 1,196 copies or any other copies of the alleged copyrighted painting.

The former judgment adjudged that said 1,196 sheets had been " made in violation of plaintiff's copyright," but did not adjudge that said sheets had been so made by the defendant, nor that the defendant had anything to do with working, copying, printing or publishing the sheets.

If the Lithographic Company printed the copies as alleged in the Replevin complaint, then the defendant here did not "work, copy and print" the same copies.

The replevin judgment, therefore, did not prove the allegation of the complaint in the action at bar or tend to prove it because there was no correspondence of the *res adjudicata* of the judgment with the allegation of the complaint.

Having infringing sheets *in possession* did not of itself make the possessor liable to the money penalty under § 4965, and is not alleged in the pending case as an incriminating act, and did not prove that defendant had either worked, copied, printed or published those sheets or any other, and, in fact, rather negatived the idea of having published those sheets.

The replevin complaint alleged that defendant "caused said copies to be printed for it."

"Causing" to be printed does not render a person liable to the penalty of $10 per sheet, this being a penal statute. If defendant *knew* the sheets to have been *wrongfully* printed or published, the penalty might attach provided it had sold or exposed them to sale. If defendant *knew* the sheets to have been wrongfully printed, and then, with such knowledge, had merely published them without selling or exposing them to sale, the penalty would not attach. Defendant might have caused the sheets to have been printed by the Lithographic company without knowledge that they had been wrongfully printed or published. Defendant might have caused the printing by simply giving an order to the Lithographic company to print copies upon exhibition to it of a sample copy and without knowledge that the sample copy was an infringement. Defendant might have caused the printing by simply ordering a picture without specifying the subject of the picture desired and leaving that to the taste of the Lithographic company as printers. "Causing" is a comprehensive expression. Conjecture can speculate as to the number of ways in which the defendant without liability might have caused the Lithographic company to have printed the copies. It is enough that

Section 4965 does not attach any penalty to *causing* copies to be printed.

The replevin judgment recites respecting the sheets found in possession "said sheets *having been made* in violation of plaintiff's copyright."

But the judgment does not adjudge *by whom* they had been made, and, certainly does not adjudge that they had been made by defendant. If the fact was that they had been made by the Lithographic Co. the adjudication would have corresponded better with the allegation of the replevin complaint that defendant had *caused* certain *copies to be printed for it.*

However that may be, the finding in defendant's possession of 1,196 sheets "having been made in violation of plaintiff's copyright" did not prove that defendant had worked, copied, printed or published them.

Nor do the words of the replevin judgment "all as alleged in the plaintiff's complaint" add anything to the probative force of the judgment. Those words qualify only the preceding words "found in the possession of the defendant and replevied by the United States Marshal."

The replevin complaint alleged that defendant was in possession of 7,338 sheets, that 203 copies had been seized by one Marshal (Southern Dist.), and 993 copies by another marshal (Western Dist.) (see marg. pp. 35 and 36). That part of the judgment did not prove that defendant had worked, copied, printed or published either the replevied or any other sheets.

The maxim *facit per alium facit per se* does not apply. If the maxim might be applied in a penal action, it cannot in this, because there are no facts alleged in either complaint upon which it can be predicated. Causation is not agency.

The judgment in the former action (Replevin) may have passed, for anything that appears, on the allegation that the defendant caused the copies to be printed by the Lithographic Company, and that act, as said above, is not one to which a penalty is attached and is

not an incriminating act alleged in the complaint in the action at bar.

Plaintiff may say if the act of *causing* the copies to be printed does not justify the penalties, neither did it justify the judgment of forfeiture, and therefore we must assume that the judgment of forfeiture of the sheets was predicated on some other act of the defendant—that is, publishing some sheets, which is also alleged in the replevin complaint.

Not so. Plaintiff may not *impeach* his own judgment any more than defendant can. If the Court in the former action (replevin) passed judgment against defendant on the ground that the defendant had, as alleged, *caused* the sheets to have been printed by the Lithographic Co., defendant is not at liberty in the pending suit to say that that alleged fact was insufficient to authorize the judgment. That error can be corrected only on defendant's appeal from that judgment. If defendant cannot, in the pending action, impeach the former judgment in that respect, neither can plaintiff. Therefore, plaintiff cannot, in the pending suit, say that his allegation in the replevin complaint that defendant *caused* the sheets to be printed was immaterial.

We may admit that the legality of the former judgment cannot be inquired into in this action, if the Court had jurisdiction. As to all matters sufficiently pleaded, actually tried and determined, it is conclusive until it is reversed. But its binding force is limited to those matters, and as to everything else it is impertinent.

If the judgment in the former action passed upon its allegation of *causing* to be printed (conjecturally it did), then that judgment is not relevant to the present action, because there is no allegation in the present action that the defendant *caused* any of the sheets to be printed.

In *Washington vs. Sickles*, 24 How. (U. S.), 333, the plaintiffs had, in a former action, sued upon a special parol contract for part of a price, and had recovered.

In the second action, for the remainder of the price, the plaintiffs in the first count set up the former verdict and judgment and claimed that they had thus established conclusively the contract, and produced the record of the former action as the only evidence of the contract. But the record in the former case showed a declaration containing *two* special counts upon the contract and the *common counts*, a docket entry of a *general* verdict for plaintiffs on the *entire* declaration. "The *special* counts in the declaration of each suit" were "similar." The Court said:

"*But the verdict might have been rendered upon the entire declaration*, and without special reference to the first count," and "The judgment rendered in that suit, "while it remains in force, and for the purpose of "maintaining its validity, is conclusive of all the facts "properly pleaded by the plaintiffs. *But when it "is presented as testimony in another suit, the inquiry is "competent whether the same issue has been tried and "settled by it.*" (Italics ours.)

And the judgment below was reversed on the ground that the Circuit Court had erred in holding that the plaintiffs in error were estopped by the proceedings in the former suit from any inquiry in respect to the matters in issue and actually tried in that cause.

The controversy again came up in *Packet Co. vs. Sickels*, 5 Wall., 580, where extrinsic evidence had been introduced to show that the same contract had been in controversy in the former case and had been adjudicated in their favor. But the declaration in the former suit contained four counts of which the first and fourth set up two different special contracts relating to the same subject, and identical with a single exception. The extrinsic evidence "tended to prove either count, "and was sufficient to have justified the jury in find-"ing either contract." The Court laid down this rule (p. 592):

"but even where it appears from the extrinsic evidence that the matter was properly within the issue controverted in the former suit, if it be not shown that the verdict and judgment *necessarily involved its consider-*

ation and determination, it will not be concluded." (Italics ours.)

Therefore we submit that a former record is without probative force unless it appears by it or by extrinsic proof that exactly the same question was actually litigated and determined.

It is not enough that the pleadings show that the same question *might have been* litigated and determined; nor that the same question was litigated, but was not determined; nor that the same question was determined but not litigated. *Actual litigation and determination must concur.*

Russell vs. Place, 94 U. S., 606, refers to the two Sickles' cases, cited above, and states the Court's understanding of them as follows (p. 608):

" that, to render the judgment conclusive, it must appear by the record of the prior suit that the particular matter sought to be concluded was *necessarily* tried or determined—that is, that the verdict in the suit could not have been rendered without deciding that matter; or it must be shown by extrinsic evidence, consistent with the record, that the verdict and judgment necessarily involved the consideration and determination of the matter."

The suit was in equity for infringing a patent. In a former action at law the plaintiff had recovered a verdict and in the equity suit claimed that the verdict established the validity of the patent. But the patent had two claims, and the Court said:

" The verdict may have been for an infringement of
" the first claim; it may have been for an infringement
" of the second; it may have been for an infringement
" of both. The validity of the patent was not neces-
" sarily involved, except with respect to the claim
" which was the basis of the recovery,"

and concluded

" If upon the face of a record *anything is left to con-*
" *jecture* as to what was necessarily involved and de-
" cided, there is no estoppel in it when pleaded, and
" nothing conclusive in it when offered as evidence."
(Italics ours.)

In *Johnson Co. vs. Wharton*, 152 U. S., 261, it was said, the inquiry is

" whether the questions ought to be raised in the sub-
" sequent suit was covered by the pleadings and
" actually determined in the former suit."

In *Burlen vs. Shannon*, 99 Mass., 200, Chief Justice SHAW is quoted as saying in a former case : " It is only
" when a fact is specially put in issue, traversed and
" tried, that a verdict and judgment following it are
" evidence against the parties."

And at page 204, the Court cites *McDowell vs. Langdon*, 3 Grey, 513, and says thereof :

" It was directly adjudged that a verdict and judgment are not conclusive unless it appear by the record or by parol evidence in addition thereto that the prevailing party in the former suit prevailed upon the very issue in support of which he offers the record in evidence. There the two cases were between the same parties and of the same nature. In the first, the defendant pleaded not guilty to a charge of obstructing the flow of water to plaintiff's mill, and also a right to use the water in the manner complained off, When he relied upon the record of the first judgment in his favor as a bar to the second action to similar subsequent torts, it was left doubtful on which of the two counts he prevailed on the former trial, and for this cause the Court held that the plea could not be sustained."

In *Cromwell vs. County of Sac*, 94 U. S., 351, the Court quoted the language of Lord ELLENBOROUGH (p. 353) with approval :

" It is not the recovery, but the matter alleged by
" the party, and upon which the recovery proceeds,
" which creates the estoppel."

That is, it is the *allegations* of the party recovering and the *proofs* thereunder, and the *determination of the issues thus made and tried* which work the estoppel.

And in *McCarty vs. Lehigh Valley R. R.*, 160 U. S., 110-120, it was said that there must be certainty to every intent to constitute an estoppel.

Also Campbell vs. Rankin, 99 U. S., 261.

The Inquiry as to the Identity of the Cause of Action in the Two Cases.

The judgment roll in the replevin action could have been relevant in any respect only on the consideration that the sheets forfeited in that action are the sheets upon which the penalty is claimed in the pending action.

Assuming that to be the fact, although it was not proved unless the Marshals' returns would have proved it, then the question would be: Did the plaintiff have more than one cause of action against the Defendant?

If he had only one cause of action, then certainly he was bound to sue for the forfeiture of sheets, and for the money penalty on those sheets in a *single* action. (See our Fourth Point below).

If the statute gave him two causes of action, then the rule of estoppel which controls him is as stated in *Nesbit vs. Riverside Independent District*, 144 U. S., 610–618, where it was said:

> " When a second suit is upon the same cause of ac-
> " tion, and between the same parties as a former suit,
> " the judgment in the former is conclusive in the latter
> " as to every question which was or might have been
> " presented and determined in the first action; but
> " *when the second suit is upon a different cause of ac-*
> " *tion*, though between the same parties, *the judgment*
> " *in the former action operates as an estoppel only as to*
> " *the point or question actually litigated and determined,*
> " *and not as to other matters which might have been liti-*
> " *gated and determined*" (Italics ours).

The foregoing was said in an action upon coupons, and it was held that each coupon was a separable promise and occasioned a separate cause of action.

The burden of proof is on the party alleging the estoppel.

This proposition logically follows from the principles which make the former record an estoppel.

In *Dunckel vs. Wiles*, 11 N. Y., 420, it was said:

> " *It is not upon a possibility or probability, however strong, that an estoppel can rest. The matter of the*

estoppel must actually have come in question and been determined. The burthen of showing that it did come in question, must fall upon the party who seeks the benefit of the estoppel ; for it is a part and a necessary part of his case."

Applying the foregoing rules :

It was incumbent upon plaintiff to prove that defendant " did work, copy, print and publish copies of said copyrighted painting."

Plaintiff so alleges. Section 4965 required it. The former judgment adjudges only that plaintiff is entitled to possession of 1,196 sheets " found in the possession of the defendant" * * * " said sheets having been made in violation " of the copyright.

They may have been made by some one other than defendant ; if so, defendant was not culpable. Having the sheets in possession was not an offense.

The allegation of the former complaint was that defendant " caused said copies (*i. e.*, 7,338 sheets) to be printed for it by the American Lithographic Company, and upon delivery thereof to defendant, published *some* of said sheets."

The allegation did not state an offense under Section 4,965, but if it did, the judgment does not find the facts as alleged, and the allegation is not the same as in the complaint in the pending case. There is no certainty as to what was litigated.

As the verdict in the replevin action was found by direction of the court, resort must be had to the judgment to learn what was determined.

The only matter determined was that certain sheets found in defendant's possession be forfeited, and their value. There should have been some ground of forfeiture, but on what ground the judgment went is left to conjecture. Possibly it was on the ground of " said sheets having been made in violation of plaintiff's copyright." If so that ground is not pleaded in the pending action as a basis for penalties.

THIRD POINT.

The exclusion of the Marshal's return was not error.

In the preceding point we have considered the papers as if they were in evidence.

The papers offered consisted of " the return of the Marshal "—" to which is attached an undertaking, summons, a writ of replevin, affidavit and specimens of the picture in question " (marg., p. 28).

None of them possessed the slightest probative force either with or without the judgment. They were each immaterial as well as incompetent. The summons was already in the judgment roll, the undertaking was valueless, the affidavit was incompetent as an *ex parte* statement, the writ proved nothing, and the Marshal's return on it was merely his certificate that he had replevied some sheets, a fact mentioned in the judgment.

If the Fourth Point in our brief for plaintiff-in-error in the case of *American Tobacco Company vs. Werckmeister* preceding this was well taken, said papers were also not admissible because they were illegal.

FOURTH POINT.

A second and separate action will not lie for penalties after a judgment in a former distinct action for forfeiture of sheets.

Although this point was not presented to the Court below until plaintiff's motion for a new trial and therefore did not constitute matter of exception yet

" A defendant in whose favor a verdict has been ren-
" dered by direction of the court is entitled to sup-
" port such verdict upon any ground which the evidence

" in the record permits, and of which he has not by his " conduct waived the right to avail himself. If, upon " all the evidence, the verdict was one which must nec- " essarily have been rendered, it must stand, regardless " of the sufficiency of the particular ground on which " it was directed."

Whitney vs. New York, N. H. & H. R. Co., 102 Fed. Rep., 850 (C. C. A., 1st Circuit).

See, also, *Moffatt vs. Smith*, 101 Fed. Rep., 771,

There cannot be two actions, one for the forfeiture of sheets, the other for the money penalty.

There is only *one* offense committed by doing one or other or all the things mentioned in Section 4965.

The section says, "If any person * * * shall * * * engrave, etch, work, copy, print, publish, *et cet.* * * * *he* shall forfeit" the plates and sheets, "and shall further forfeit one dollar for every sheet of the same *found in his possession*, * * * and in case of a painting, &c., *he* shall forfeit ten dollars for every copy, &c."

There are two punishments for the single offense, viz: forfeiture of sheets and forfeiture of money.

The plaintiff claimed that the issues in the two actions were identical (marg., p. 23), saying that they were "exactly the same. They are precisely the same."

Under our Second Point we contend that the *issues* in the two actions were not the same, but that is because the single *offense was variously pleaded* in the two complaints.

Cases of violation of the Revenue Laws, where proceedings *in rem* against the forfeited property and against the person to recover a fine are prescribed by statute, have no application.

A forfeiture of infringing sheets under Section 4965 cannot be worked out in a proceeding *in rem*, because Section 4965 says "*he* shall forfeit, &c." But statutes prescribing forfeiture of unlawfully distilled spirits, the implements, &c., used in connection with such

illegal acts, make the *things themselves* forfeited, and direct their seizure and provide proceedings *in rem* to complete the forfeiture.

Revised Statutes 3450 and 3453 are specimens of such statutes.

In such cases it may be that the proceeding *in rem* for the forfeiture and the proceeding *in personam* for the fine may be separate. In the one proceeding the Government seizes the things in whosoever possession they may be and make its title good by a judgment; in the other it sues the person to recover the fine for the offense, and against *him* there is only one suit.

But, if plaintiff's view of the procedure under Section 4965 is right, there may be, indeed must be, two actions against the *same* person, both *penal* in their nature, *i. e. quasi* criminal, one to forfeit sheets, the other to forfeit money, and both arising out of the single offense.

Section 4965 provides the punishment, *i. e.*, forfeitures and penalties, but does not intimate in any manner that *two* actions can be brought and, so far as expression goes, suggests only *one* action.

We should not suppose that the punishments would be inflicted in two distinct proceedings. If the United States is not a party to the penalty action, as plaintiff contends, that view is strengthened by that consideration.

Bolles vs. Outing Company, 77 Fed. Rep., 966 (decided January, 1897, by Circuit Court of Appeals, 2nd Circ.) was to recover penalties. The plaintiff offered to prove that a certain number of copies had been delivered by the printers into the possession of the defendants. The evidence was objected to and the objection was sustained. The Court of Appeals affirmed that ruling and said (p. 968):

"We are of the opinion that the section means to affix the penalty only when the sheets are shown to have been *discovered or detected* in the possession of the defendant prior to the bringing of the suit. The statute is apparently framed to give the party whose

copyright has been invaded *complete relief by an action* in which he can procure a condemnation of the infringing sheets, and *at the same time* recover, by way of compensation, a penalty for every sheet which he is entitled to condemn. The words 'found in his possession' aptly refer to a finding for the purposes of forfeiture and condemnation. The remedy by condemnation and forfeiture is only appropriate in a case where the property can be seized upon process; and where, as here, the forfeiture declared is against property of the 'offender,' it is only appropriate when it can be seized in his hands. *The section contemplates two remedies, enforceable in a single suit*, each of which depends upon the same state of facts. The aggrieved party may, at his election, pursue either one or both remedies. But it does not contemplate a recovery of penalties, except in respect to the sheets which can be condemned."

Strictly these remarks were not *obiter;* they were germane to the question and necessary as part of the reasons which induced the holding.

Bolles vs. Outing Co., 175 U. S., 266, was the same action as 77 Fed. Rep., 966, after a new trial ordered for errors other than those mentioned above. Upon the new trial the same evidence as to the number of copies found in the possession of the defendant was excluded and a verdict was directed for plaintiff for one dollar penalty for the one copy bought by plaintiff's employee from the defendant. Plaintiff had moved for a new trial because of this ruling, and upon its denial went to the Circuit Court of Appeals, which affirmed the judgment, and upon that went to the Supreme Court. The Supreme Court affirmed the ruling, and said (p. 266):

"*No remedy is provided by the act*, although by section 4970 a bill in equity will lie for an injunction; but the provision for a forfeiture of the plates and of the copies *seems* to contemplate *an action* in the nature of replevin for their seizure, and in addition to the confiscation of the copies, for a recovery of one dollar for every copy so seized or found in the possession of the defendant."

Falk vs. Curtis Pub. Co., 98 Fed. Rep., 989-991 (Circuit Court) was an action for the money penalty only. A demurrer on the ground that the statement of claim did not allege that "any number of said sheets were so found" in possession "prior to the bringing of the suit," was sustained.

Falk vs. Curtis Pub. Co., 100 Fed. Rep., 77, was the same case, and again on demurrer to the amended complaint in which the omission was supplied. Here, the demurrer was overruled.

In neither of the cases did it appear that there had been any prior action for a forfeiture of sheets, and the question discussed under this point did not arise.

Falk vs. Curtis Publishing Co., 102 Fed. Rep., 967 (decided July, 1900, by McPherson, D. J.), was the same action as above, and in assumpsit to recover the penalties. The plaintiff had purchased one copy of the incriminating magazine and later on the same day simultaneously served two writs—one a writ of replevin and the other a summons in the assumpsit case.

The learned Judge queried (p. 969):

"What, then, is the appropriate course of proceeding for the purpose of enforcing the forfeiture alone, or for collecting the penalty alone, or for the double purpose of enforcing the forfeiture and also of collecting the penalty?"

He did not, however, answer his own question, but said (p. 971):

"The precise question, therefore, is not whether a single action would lie, both for condemnation and for penalty, but whether, since the plaintiff has chosen to bring two suits, the action of assumpsit was not prematurely brought, or, in other words, whether the plaintiff had a cause of action for the penalty at the time the writ in assumpsit was issued. In my opinion assuming two suits to be permissible, he had no such cause of action, and the defendant is therefore entitled to judgment upon the pending motion."

That conclusion being on the consideration that "The action of replevin has not yet been tried" (p. 971) and it did not appear that anything had been done

in it. The substance of the decision was that no sheets had been *found for purposes of condemnation and forfeiture*, and, hence, the assumpsit action had been prematurely brought. "The purchase of one "copy by the boy was not a finding for purposes of "condemnation and forfeiture, and gave no right to "sue, even for the minimum penalty of $100."

Falk vs. Curtis Publishing Co., 107 Fed. Rep., 126 (decided February, 1901; C. C. A., 3d Circuit), was a review of the decision of Judge McPherson last above referred to. The Court said (p. 128):

"that the forfeiture arises, not on the subsequent finding by a jury, but on an actual finding of sheets in the defendant's possession, is evidenced by the fact that the finding specified in the act refers to an act then being carried on, viz. 'either printing,' or to an existing condition, viz. 'exposed to sale.'" * * *

"In the case in hand there was no seizure by condemnation, forfeiture, or otherwise before the bringing of the present suit, no prints had been found in the defendant's possession when the summons in assumpsit issued, and consequently the defendant had not then 'forfeit (ed) one dollar for every sheet found in his possession.' If there was no forfeit when the action began, it follows there was no existing right of action to recover the fruit of the forfeiture; for an action is the prosecution of an existing right. There must be finding before there is forfeiture; there must be forfeiture before the right accrues to sue for the forfeited penalty."

Thus affirming Judge McPherson's ruling, but the reasoning seems somewhat illogical, because, there can be no forfeiture until a *judgment* of forfeiture adjudges it. Forfeiture does not occur by merely commencing the action to obtain a forfeiture. If merely *serving* the writ amounted to forfeiture, or the later judgment of forfeiture related back to the service of the writ or even the commission of the offense, then Falk was right in serving his writ in assumpsit at the same time as the writ in replevin, if two independent actions can be maintained. If the judgment of forfeiture relates back at all, it is to the service of the writ and not to some intermediate step. If the

plaintiff must establish the forfeiture of the sheets by judgment, before he has a standing to sue for the penalties, then it might be that his right to sue for penalties (within two years) would be lost before the forfeiture judgment can be obtained if separate actions are proper.

That the forfeiture does not relate back to the time of the offense, but only to the commencement of the action, if at all, is argued in our brief in *American Tobacco Co. vs. Werckmeister* (No. 287 on the Docket), at p. 78 *et seq.*

The solution of the matter seems to be to permit in one action a forfeiture of sheets found in possession when it is commenced and in the *same* action to adjudge the penalties for the sheets so found.

And if the statute permitted a seizure of the sheets, the difficulties arising from want of evidence to establish the *finding* of sheets and the amount of the penalty would seem to be overcome.

If § 4965 is defective and requires amendment, we submit that this should be acknowledged, instead of attempting to remake the language.

In *Morrison vs. Pettibone*, 87 Fed. Rep., 330 (N. D. Ill.), SEAMAN, D. J., held that replevin was a proper remedy to enforce a forfeiture, but somewhat doubtfully. He thought that the ruling might

> " be based upon the hypothesis that the term ' forfeit,' as used in the statute, is not to be taken in its strict, ordinary sense; that the act of congress, clearly intending to give to the proprietor an exclusive right of property in that which has been produced by his mind and skill, confers as well an ownership in all copies which are made by infringers; that through the act of piracy the title to the imitation vests in the proprietor of the copyright, in that sense only being forfeited; and, so regarded, replevin would lie to obtain possession."

The hypothesis is based upon an erroneous premise. The Copyright Act does not give the proprietor " an exclusive right of property in that which has been produced by his mind and skill." It gives him only an

exclusive right *to copy* the production. The *plates* which are also forfeited would not, on the same hypothesis, be his property. A further answer is that the term "forfeit" is inconsistent with the hypothesis. A person *forfeits* that which is *his* to the one on whom the law bestows it. A person who recovers *his own*, does not recover by way of *forfeiture*. The hypothesis would seem to be judicial legislation.

FIFTH POINT.

The judgment roll was not competent evidence under Section 860 U. S. Rev. Stat.

The Marshals' returns were properly excluded also for the same reason.

Section 860 provides:

"No pleading of a *party*, nor any discovery or evi-
"dence obtained from a *party* or witness *by means of*
"*a judicial proceeding* in this or any foreign country,
"shall be given in evidence, or *in any manner used*
"*against him or his property*, or estate, in any court of
"the United States, in any criminal proceeding, *or for*
"*the enforcement of any penalty or forfeiture; pro-*
"*vided*, that this section shall not exempt any party
"or witness from prosecution and punishment for
"perjury committed in discovering or testifying as
"aforesaid."

Section 860 is especially applicable to actions "for the enforcement of any penalty or forfeiture," and in effect deprives the judgment roll of all evidentiary force. Criminal, forfeiture and penalty cases must each stand upon its own bottom, so far, at least, as permitting the plaintiff to prove his case by evidence extorted from the defendant by a judicial proceeding.

Boyd vs. United States, 116 U. S., 616, was an in-

formation filed by the District Attorney in July, 1884, in a case of seizure and forfeiture of certain goods, seized by the collector as forfeited to the United States under Section 12 of an Act passed June 22, 1874 (18 Stat. at L., 186), the alleged cause of forfeiture being undervaluation. The claimants of the goods pleaded non-forfeiture. The District Judge had made an order under Section 5 of the same act requiring the claimants to produce the invoice of the goods. The claimants produced the invoice, but objected to the validity of the order and the constitutionality of the law which authorized the order, and when the invoice thus produced was offered in evidence by the District Attorney the claimants objected to its reception on the ground that in a suit for forfeiture no evidence can be compelled from the claimants, and that the statute which compelled the production of the evidence to be used against the claimants was unconstitutional. The objections were overruled and the trial resulted in a verdict for the Government and judgment of forfeiture was given. The claimants by writ of error brought the question to this Court.

Section 860 R. S. quoted above was a revision of an Act passed February 25, 1868 (15 Stat. at L., 37) entitled "An Act for the protection in certain cases of persons making disclosures as parties or testifying as witnesses" (see 116 U. S. at p. 632), which Act was in force until the Revised Statutes of 1875 superseded it, and hence was in force when the Act of June 22, 1874, authorizing the order, was passed. The Act of June 22, 1874, did not repeal the Protection Act of 1868. The Protection Act of February 25, 1868, having been superseded by Section 860 R. S., both that section and the Act of 1874 were in force when the proceedings in the Boyd case were commenced. The claimants in the Boyd case could not claim protection under Section 860, because that section being a revision of an Act passed in 1868 was dominated by the Act of 1874 under which the illegal order was made, and so the Court said (p. 633): "It "would hardly be admissible to considerthe Act of

" 1868 as having any influence over the construction " of the Act of 1874," and for the purpose of the discussion, the Court regarded the fifth section of the Act of 1874 (under which the illegal order for producing the invoice had been made) as independent of the Act of 1868. The fifth section of the Act of 1874 was held by the Court unconstitutional and void.

The foregoing is stated for the purpose of showing that in 1884, when the seizure proceedings were commenced, the claimants would have been protected under Section 860 from an offer in evidence against them of an invoice obtained from them by compulsory process, but for the unconstitutional Section 5 of the Law of 1874.

The Execution of the Replevin Writs and the Replevin Action and the Judgment Obtained Therein Were Judicial Proceedings.

Therein and thereby evidence was obtained of the *possession* by defendant of certain alleged incriminating sheets. Section 860 forbids that evidence so obtained " be given in evidence or in any manner used against " him."

The order in the Boyd case was made by the district Judge, was entitled in a proceeding *in rem*, and was served by the Marshall, and required the claimants to produce a certain invoice, and that invoice was used to effect a forfeiture of the goods. That order was a writ in every sense of the term, being a judicial instrument by which a Court commands something to be done by the person to whom it is addressed. There is no difference in principle, so far as the present question is concerned, between such a writ and the writs of replevin by which the Marshalls were commanded to seize certain property, not merely for the purposes of forfeiting the sheets, but also for the purpose of establishing that the sheets were " found in possession " of

the defendant, so that in respect of those sheets a forfeiture of $10 for each sheet so found in possession might attach.

The question of the illegality of the issuance of those writs of replevin without the sanction of a statute of the United States authorizing them is not here discussed, nor do we here raise the question that the seizure of those sheets by the Marshal for the purpose of having them adjudged forfeited might not lawfully be made in an action brought to adjudge the forfeiture of them. Those questions are raised in our writ of error from the Replevin action, expected to be argued immediately preceding the present case.

But we do make the point that to obtain evidence in that way, whether those means are legitimate or not in the action in which they are used, and to use that evidence in another action brought to recover a penalty, is a contravention of the rights of a party secured under Section 860, because it is evidence obtained from a party "by means of a judicial proceeding."

No distinction can be drawn in this respect between the writs of replevin and their execution by the Marshall and the judgment founded on them.

The ninth clause of the complaint in the replevin action alleges (marg. p. 36) that 203 copies were, at the commencement of that action seized by the Marshal of the Southern District under a writ of replevin and "are now" (were then) in the hands of the Marshal or the Clerk of the Court in pursuance of the execution of that writ, and that 993 copies were seized by the Marshal for the Western District under a similar writ, and "are" (were) similarly in the hands of that Marshal, pursuant to that writ. The replevin writs, Marshal's returns and affidavits were not part of the judgment roll in the replevin action, and were offered in evidence separately after plaintiff had rested (marg. p. 28) and were excluded, and their exclusion is assigned as error. The judgment adjudged that the plaintiff have and retain the 1,196 sheets "found in the possession of the "defendant and replevied by the United States Mar-

" shal, all as alleged in plaintiff's complaint " (marg. p. 74).

Section 860 forbids the use of the inhibited evidence "in any manner." The judgment as evidence is as open to objection as the writs themselves coupled with evidence of the proceedings of the marshal thereunder. Crystalizing the writs and the proceedings thereunder into the form of a judgment does not evade the inhibition of Section 860.

If the defendant had admitted by its answer in the replevin action the allegations of the ninth clause respecting the replevies and proceedings thereunder, such admission could not have been used against the same defendant in this action for a penalty, and if not, no discovery or evidence otherwise obtained in that action by means of a judicial proceeding therein could be so used.

A Corporation May Invoke the Protection Afforded by Section 860.

Section 860 exempts the " pleading of a *party* " and the " discovery or evidence obtained from a *party.*" " Party " includes a corporation.

If it be objected that the pronouns "him" and "his" are used in the section, the answer is that the same pronouns " he " " him " and " his " are used in Section 4965 under which this action was brought. If in Section 860, " him " and " his " do not include corporations, then "he" "him" and "his" and the introductory word " person " of Section 4965 do not include corporations. It would be unreasonable to hold that the answer of a natural person (being a party) could not under this section be used in another action which is a penal one, but the answer of a corporation in the like case could be. (See Rev. St., sect. 1.)

The Circuit Court of Appeals (1st Circ.) in *American Tobacco Co. vs. Werckmeister*, 146 Fed. Rep., 375, at pp. 376, 377, and *American Lithographic Co. vs. Werckmeister* at p. 378, construed the ruling of this

court in *Hale vs. Henkel*, 201 U. S., 43, to deprive a corporation of the protection of the Fourth and Fifth Amendments to the Constitution (see pp. 376, 377).

In that case the application of Section 860 to corporations was not considered. Nor do we understand that the rule held in *Boyd vs. U. S.* was impaired or questioned.

The point now urged is not within the ruling of this Court in *Hale vs. Henkel*, where the protection of the Fourth and Fifth Amendments to the Constitution alone were invoked by the petitioner. Here the corporation invokes the protection of Section 860. We have cited *Boyd vs. U. S.* above not for the purpose of indirectly seeking the shelter of the Fourth and Fifth Amendments, but for the purpose of showing that Section 860 protects a defendant in a penalty case under Section 4965 and would have been sufficient to protect the plaintiffs-in-error in that case, but for Section 5 of the Act of 1874. The case at bar cannot be distinguished from the *Boyd* case in respect of the nature of the evidence upon which Section 860 operates. So that the question now presented is whether Section 860 applies to a corporation.

In our brief in No. 287, *American Tobacco Co. vs. Werckmeister*, expected to be argued immediately preceding the present case, we have said (p. 101) that we did not present the question whether or not a corporation can invoke the said constitutional provisions against the compulsory giving of evidence against itself in penal cases which are not within the principal of governmental supervision and control expounded in *Hale vs. Henkel*, and we do not present that question now and for the same reason, *viz.*, that we expect to raise that question in another case.

SIXTH POINT.

The Former Judgment was Not an Estoppel Because that Action was Not Between the Same Parties as this Action.

If a judgment of forfeiture of sheets and a judgment for the money penalties can be obtained in separate actions, then the question arises whether the parties to the action now at bar are the *same* as the parties to the former action.

For estoppel it is essential that the parties should be the same in both actions;—the same in interest.

In *Collins vs. Hydorn*, 135 N. Y., 324, it was said:

"But the mere fact that the same persons are liti-
" gants in the two actions is not always sufficient to
" satisfy the rule of *res adjudicata*. The same person
" may in law be considered another person, and con-
" sequently another party, by suing in another
" capacity."

And:

" The rule is that a former judgment concludes the
" party only in the character in which he was sued and,
" therefore, a judgment for or against an executor, ad-
" ministrator, assignee or trustee as such presump-
" tively does not preclude him, in a different cause of
" action affecting him personally from disputing the
" findings or judgment though the same questions are
" involved."

See, also, Bigelow vs. Estoppel, 5th Ed., pp. 130, 131, and cases there cited.

In *Rathbone vs. Hooney*, 58 N. Y., 467, it was held that a judgment against a party sued as an individual is not an estoppel in a subsequent action in which he sues or is sued in a representative capacity. " In the
" latter case he is in contemplation of law a distinct
" person and a stranger to the prior proceedings and
" judgment."

Estoppels must be mutual. If there is no mutuality there can be no estoppel.

If the replevin action had gone *against* Werckmeister

would that judgment have barred this action, which is brought on his behalf and that of the United States? If it would not, then it is no bar against the defendant, for lack of mutuality.

Sec. 4965 provides that the infringer "shall forfeit *to the proprietor* all the plates * * * and every sheet." * * * The United States has no interest in this forfeiture of sheets, because the sheets are forfeited to the proprietor alone.

Respecting the forfeiture of the money penalties the language changes.

There is no forfeiture *expressly* to the proprietor of any money penalties. The word "forfeit" is used respecting the money penalties, but after specifying the rate, the language is "one-half of all the foregoing penalties "shall go the proprietor of the copyright, and the "other half to the use of the United States." The copyright proprietor and United States each derives a one-half interest in the penalties from the same language."

If separate actions can be brought to establish forfeiture of sheets and to recover the penalties, why may not the United States be a party plaintiff conjointly with the proprietor, or why may not the United States commence an action in its own name for the use as to one-half to the proprietor, if the proprietor can commence such an action? The section does not say that the proprietor may begin an action, nor that the United States may. The right of either or both to maintain an action is merely inferred from the fact that an interest in the recovery is given to both.

These penalties are fines. Fines belong to the State, but the State may give any part thereof, or the whole, to an informer. Ordinarily it has been thought necessary in order to authorize a private person to sue, to make a provision to that effect in the act establishing the fine by the words "payable to any one who shall sue for the same" or by words of that import. Nothing of that sort is found in Sec. 4965.

Perhaps the practice of permitting the proprietor to sue on his own behalf and on behalf of the United

States under Sec. 4965 is too firmly established to be successfully challenged now, but it does not alter the fact that, under the language of the Act, the United States is, as much as the proprietor is, interested in the recovery.

Werkmeister, if he could be a sole plaintiff, nevertheless, was a trustee in respect of one-half of the cause of action.

The proprietor, if he may sue, does so on his own behalf and also in behalf of the United States, and therefore in a *representative* capacity. True, the United States cannot recover unless the proprietor can, but the proprietor cannot recover unless the United States can. The proprietor really sues in the right of the United States, and because the latter has given him one-half of the fine. If he can sue alone, why is he not a trustee in respect of the half which goes to the other. Why should the United States recover by virtue of the estoppel of a judgment in an action to which it was not a party or a privy.

The plaintiff being a trustee in respect of half the cause of action was not the same *party* as in the former action.

The judgment of the Circuit Court of Appeals affirming the judgment of the Circuit Court should be affirmed with costs.

WM. A. JENNER,
Of Counsel for Defendant-in-error.